

349. (New) The method of claim 342, wherein the client further includes a client computer and wherein the received data further includes application data to be processed by the client computer, the method including utilizing the application data to facilitate an interaction between the client and a user.

350. (New) The method of claim 349, including executing computer code within the application data to facilitate the interaction.

351. (New) The method of claim 349, including utilizing data, included with the application data and to be used by computer code executable by the client computer, to facilitate the interaction.

352. (New) The method of claim 342, wherein the displaying of the images includes generating television images.

353. (New) The method of claim 342, including generating graphics, in response to execution of computer code by the client, for display by the client.

354. (New) The method of claim 342, including generating the received data to include computer code executable by the client to facilitate an interaction with a user.

355. (New) The method of claim 342, including generating the received data to include application data to be used by computer code executable by the client to facilitate an interaction with a user.

356. (New) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to:

receive data including at least auxiliary data representing video images at the machine;

display video images, based on the auxiliary data utilizing the machine;  
and

communicate between the machine and a local computer collocated with and in communication with the machine.

357. (New) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to:

receive data including at least auxiliary data representing video images at the machine;

display video images, based on the processed auxiliary data utilizing the machine; and


retrieving information from mass storage utilizing the machine the mass storage being in communication with the machine.

If there are any additional charges, please charge Deposit Account No. 02-2666.

If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 02/20/ 2003

  
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Patent

Attorney's Docket No. 5214P001R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kuriacose JOSEPH, et al.

Application No.: 09/672,523

Filed: September 27, 2000

For: A METHOD AND SYSTEM TO  
FACILITATE ORDERING OF AN  
ITEM (As Amended)

Examiner: Kalinowski, Alexander G.

Art Group: 3626

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Leslie Rogan

Name of Person, Filing Correspondence

Leslie Rogan

Signature

Date

11/10/03

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450.

AMENDMENT AND RESPONSE TO THE OFFICE ACTION

Sir:

In response to the Office Action mailed July 9, 2003, the Examiner is respectfully  
requested to enter this amendment and to consider the remarks that follow.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of  
this paper.

Remarks/Arguments begin on page 13 of this paper.

Amendments to the Claims:

Please cancel claims 26 and 56, without prejudice.

Please amend the claims as follows:

10. (Currently Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing ~~an~~ the item to a user via the client

enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing ~~an~~ the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify~~ the item as currently being offered for sale at the time of the single action.

11. (Previously Presented) The method of claim 10, wherein the single action is one of a group including:

selecting of a single button; and  
pressing of a single button on a TV remote control.

12. (Canceled)

13. (Previously Presented) The method of claim 10, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

14. (Previously Presented) The method of claim 10, wherein the user related, personal information is stored in memory in the client.

15. (Previously Presented) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.

16. (Previously Presented) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.

17. (Currently Amended) The method of claim ~~12~~ 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

18. (Previously Presented) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:

the client retrieving information from one or more of the local computer and the associated storage.

19. (Previously Presented) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Previously Presented) The method of claim 18, wherein the local computer is part of a local area network.
21. (Previously Presented) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:  
    sending information used in processing the order from the client to the central processing facility.
22. (Previously Presented) The method of claim 10, further including:  
    sending an order confirmation to the user to confirm the order.
23. (Previously Presented) The method of claim 21, further including:  
    communicating information between the client and the server via the central processing facility.
24. (Previously Presented) The method of claim 23, wherein a telephone system acts as the central processing facility.
25. (Currently Amended) The method of claim 10 including receiving at the client data including  
    ~~(a) information to at least one of show and describe the item via the client;~~  
    and  
    ~~(b) information to enable the user to order the item by the single action with respect to the client.~~
26. (Canceled)

27. (Currently Amended) The method of claim 26 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Currently Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to the item identifier information to identify~~ the item that is as currently being offered for sale at the time of the single action.

30. (Canceled)

29. (Currently Amended) The method of claim 28, wherein the single action includes a at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

31. (Previously Presented) The method of claim 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.



32. (Previously Presented) The method of claim 28, including retrieving the user related, personal information from a memory associated with the client.
33. (Previously Presented) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.
34. (Previously Presented) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.
35. (Previously Presented) The method of claim 34 wherein a telephone system acts as the central processing facility.
36. (Previously Presented) The method of claim 28 including providing an order confirmation to the client to confirm the order.
37. (Previously Presented) The method of claim 28 including multiplexing the provision of the information to at least one of show and describe the item and code to the client to thereby generate data for transmission to the client.
38. (Currently Amended) A computer system to order an item, the system including:  
    a data receiver to receive data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;  
    a data processing system to at least one of show and describe an item to a user; and  
    a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause an the order for the item to be placed,

wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to~~ the item identifier identifying the item that is as currently being offered for sale at the time of the single action.

39. (Previously Presented) The system of claim 38, wherein the single action includes at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

40. (Canceled)

41. (Previously Presented) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Previously Presented) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Previously Presented) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Previously Presented) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

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In re Application of:

Kuriacose JOSEPH, et al.

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Examiner: Kalinowski, Alexander G.

Art Group: 3626

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AMENDMENT AND RESPONSE TO THE OFFICE ACTION

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In response to the Office Action mailed July 9, 2003, the Examiner is respectfully  
requested to enter this amendment and to consider the remarks that follow.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of  
this paper.

Remarks/Arguments begin on page 13 of this paper.

46. (Previously Presented) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Previously Presented) The system of claim 46, wherein the local computer controls the client.

48. (Previously Presented) The system of claim 46, wherein the local computer is part of a local area network.

49. (Previously Presented) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Previously Presented) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.

51. (Previously Presented) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Previously Presented) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Currently Amended) The system of claim 38 including a ~~wherein the~~ data receiver is to receive the data including:

~~information to at least one of show and describe the item via the client;~~

~~and~~

information to enable the user to order the item by the single action with respect to the client.

54. (Previously Presented) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Previously Presented) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Currently Amended) The system of claim 56 ~~38~~ wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Currently Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and

an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,

wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) previously received information related to the third information identifying the item that is as currently being offered for sale at the time of the single action.

59. (Previously Presented) The system of claim 58, wherein the single action includes at least one of a group including:

- a selecting of a single button; and
- a pressing of a single button on a TV remote control.

60. (Canceled)

61. (Previously Presented) The system of claim 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

62. (Previously Presented) The system of claim 58, wherein the second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.

63. (Previously Presented) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.

64. (Previously Presented) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.

65. (Previously Presented) The system of claim 64 wherein a telephone system acts as the central processing facility.

66. (Previously Presented) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.

67. (Previously Presented) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and

the second information to enable to the client to thereby generate data for transmission to the client.

68 – 245 (Canceled)

246. (Previously Presented) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single action with the client.

247. (Previously Presented) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single action with the client.

248. (Previously Presented) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Previously Presented) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Previously Presented) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Previously Presented) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Previously Presented) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Previously Presented) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

254 – 259 (Canceled)

260. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing an the item to a user via the client;  
enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing an the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify the item~~ that is as currently being offered for sale at the time of the single action.

261. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.



263. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to~~ the item identifier information to identify the item ~~that is~~ as currently being offered for sale at the time of the single action.

264 – 357 (Canceled)

**REMARKS****1. Summary of the Office Action**

Claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Further, claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, and 263 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 5,621,456 (hereinafter Florin) in view of US Patent No. 4,734,858 (hereinafter Schlafly).

Further, claims 11, 29, 39, and 59 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of Zachary et al, "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary).

Claims 13, 14, 17, 31, 32, 41, 42, 45, 61, and 62 also stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of US Patent No. 4,163,255 (hereinafter Pires).

Claim 27 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claim 26, and further in view of U.S. Patent No. 4,965,825 (hereinafter Harvey.).

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

## 2. Response to § 251 Rejection

The Applicants respectfully disagree that the claims identified under this rejection constitute "an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based" (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the '034 patent). The Applicant's reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the "recapture rule", which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what "aspects" the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has "crept" into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the '034 patent in certain aspects, but also narrower relative to the issued

claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system. Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

*A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. ('034 patent, column 14, lines 37-45).*

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

*Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.*

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

"fundamental narrowness", identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the '034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the '034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the '034 patent. Consider for example that the claims of the '034 patent do not include any limitations directed to enabling "the user to place an order for an item by a single action." Accordingly, the opportunity did not arise during the prosecution of the '034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issued claims of the '034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that "[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application", whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner's attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the '034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

#### **1412.01 Reissue Claims Must Be for Same General Invention**

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the original patent." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

593 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.



Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

3. **Response to § 112 Rejection**

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

4. **Response to § 103 Rejections**

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a **prima facie** case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Taking claim 10 of the present reissue application as an exemplary claim for discussion purposes, the Office Action contends that "Florin does not explicitly disclose:

order the item by a single action with the client; and

wherein the enabling of the user to order the item by a single action includes 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action." (Office Action, page 6-7)

The Office Action then goes on to state that Schlaflly discloses ordering of the item by a single action with the user, and points to the disclosures in Schlaflly, quoted immediately below, in support of this position:

*Once the item has been specified it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent at 94 by automatic dialing of the local processor center 14. Once communication has been established, the entire content of the send memory is transmitted in a burst by*

*actuation of an internal modem (modulator/demodulator) 96 and the local center commences processing at 98. The send data is initially checked at 98 for verification of some of the data and a return is transmitted the data terminal at 100. The connection is then broken by the LPC and at 102 and the terminal goes "on hook". The message represented by the return is displayed at 104.*

(Schlafly, column 7, lines 35-47).

However, immediately preceding the above-quoted disclosure in Schlafly, the below disclosure is provided regarding actions that are required by a user:

*Operation of a data terminal 12 in the case of ordering of merchandise from various mail order suppliers is illustrated with FIGS. 3-6. FIG. 4 shows a portion 80 of a page from a Sears catalog. FIG. 5 illustrates a portion 82 of a J.C. Penney Catalog page.*

*As an example of a catalog order data entry, at 84 in FIG. 3 and after turn on, the user's individual subscriber secret personal authorization number, a four digit number for example, promptly by a word display, is entered. This is followed by sequentially occurring prompts, which permit entry of additional order key actuations in accordance with suitable accompanying operating instructions.*

*The first set of prompts at 86 calls for the entry of a code specifying the supplier by its catalog and a page number. The second set of prompts at 88 requires specification of the nature of the transaction, e.g. catalog number and special charge and shipping instructions if required. The third set of prompts at 90*

*requires entry of the quantity and options such as color and size when these are needed to properly specify the desired item.*

(Schlafly, column 7, lines 13-34).

Clearly, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order.

In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative with the disclosures provided in Florin.

Claim 1, as indicated above, has also been amended to include a limitation corresponding substantially to limitations of claims 25 and 26, claim 26 now having been cancelled. Specifically, claim 10 now recites the receiving of data at the client, the data including information to at least one of show and describe the item via the client, and an item identifier to enable the client to identify the item as currently being offered for sale. Claim 10 has also now been amended to recite that the enabling of the user to place the order for the item via the single action includes utilizing the received item identifier.

The above remarks also address the further rejections presented under 35 U.S.C. §103 against the other claims of the present reissue application. Specifically, the further independent claims each include limitations corresponding approximately to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

In light of the above, the Applicants respectfully submit that the rejections under 35 U.S.C. § 103 have been overcome, and withdrawal of these rejections is therefore respectfully requested.

#### 5. Conclusion

Having tendered the above remarks, and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP



Dated: 11/10/, 2003

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Amendments to the Claims:

Please cancel claims 26 and 56, without prejudice.

Please amend the claims as follows:

10. (Currently Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing an the item to a user via the client

enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing an-the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify~~ the item as currently being offered for sale at the time of the single action.

11. (Previously Presented) The method of claim 10, wherein the single action is one of a group including:

- selecting of a single button; and
- pressing of a single button on a TV remote control.

12. (Canceled)

13. (Previously Presented) The method of claim 10, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

14. (Previously Presented) The method of claim 10, wherein the user related, personal information is stored in memory in the client.

15. (Previously Presented) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.

16. (Previously Presented) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.

17. (Currently Amended) The method of claim ~~12~~ 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

18. (Previously Presented) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:

the client retrieving information from one or more of the local computer and the associated storage.

19. (Previously Presented) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Previously Presented) The method of claim 18, wherein the local computer is part of a local area network.
21. (Previously Presented) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:
- sending information used in processing the order from the client to the central processing facility.
22. (Previously Presented) The method of claim 10, further including:
- sending an order confirmation to the user to confirm the order.
23. (Previously Presented) The method of claim 21, further including:
- communicating information between the client and the server via the central processing facility.
24. (Previously Presented) The method of claim 23, wherein a telephone system acts as the central processing facility.
25. (Currently Amended) The method of claim 10 including receiving at the client data including
- (a) ~~information to at least one of show and describe the item via the client;~~ and
  - (b) information to enable the user to order the item by the single action with respect to the client.
26. (Canceled)



27. (Currently Amended) The method of claim 26 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Currently Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to the item identifier~~ information to identify the item that is as currently being offered for sale at the time of the single action.

30. (Canceled)

29. (Currently Amended) The method of claim 28, wherein the single action includes a at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

31. (Previously Presented) The method of claim 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

32. (Previously Presented) The method of claim 28, including retrieving the user related, personal information from a memory associated with the client.
33. (Previously Presented) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.
34. (Previously Presented) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.
35. (Previously Presented) The method of claim 34 wherein a telephone system acts as the central processing facility.
36. (Previously Presented) The method of claim 28 including providing an order confirmation to the client to confirm the order.
37. (Previously Presented) The method of claim 28 including multiplexing the provision of the information to at least one of show and describe the item and code to the client to thereby generate data for transmission to the client.
38. (Currently Amended) A computer system to order an item, the system including:  
a data receiver to receive data including information to at least one of  
show and describe the item, and an item identifier to identify the item as currently  
being offered for sale;  
a data processing system to at least one of show and describe an item to a user; and  
a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause ~~an~~ the order for the item to be placed,

wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier~~ identifying the item that is as currently being offered for sale at the time of the single action.

39. (Previously Presented) The system of claim 38, wherein the single action includes at least one of a group including:

selecting of a single button; and  
pressing of a single button on a TV remote control.

40. (Canceled)

41. (Previously Presented) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Previously Presented) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Previously Presented) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Previously Presented) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Previously Presented) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Previously Presented) The system of claim 46, wherein the local computer controls the client.

48. (Previously Presented) The system of claim 46, wherein the local computer is part of a local area network.

49. (Previously Presented) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Previously Presented) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.

51. (Previously Presented) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Previously Presented) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Currently Amended) The system of claim 38 including a wherein the data receiver is to receive the data including:

~~information to at least one of show and describe the item via the client;~~

and

information to enable the user to order the item by the single action with respect to the client.

54. (Previously Presented) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Previously Presented) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Currently Amended) The system of claim ~~56~~ 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Currently Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and

an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,

wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the third information identifying the item that is as currently~~ being offered for sale at the time of the single action.

59. (Previously Presented) The system of claim 58, wherein the single action includes at least one of a group including:

- a selecting of a single button; and
- a pressing of a single button on a TV remote control.

60. (Canceled)

61. (Previously Presented) The system of claim 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

62. (Previously Presented) The system of claim 58, wherein the second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.

63. (Previously Presented) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.

64. (Previously Presented) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.

65. (Previously Presented) The system of claim 64 wherein a telephone system acts as the central processing facility.

66. (Previously Presented) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.

67. (Previously Presented) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and

the second information to enable to the client to thereby generate data for transmission to the client.

68 - 245 (Canceled)

246. (Previously Presented) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single action with the client.

247. (Previously Presented) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single action with the client.

248. (Previously Presented) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Previously Presented) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Previously Presented) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Previously Presented) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Previously Presented) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Previously Presented) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

254 - 259 (Canceled)

260. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing an the item to a user via the client; enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing an the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify the item that is as currently~~ being offered for sale at the time of the single action.

261. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.



263. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to the item identifier~~ information to identify the item ~~that is~~ as currently being offered for sale at the time of the single action.

264 - 357 (Canceled)

**REMARKS****1. Summary of the Office Action**

Claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Further, claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, and 263 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 5,621,456 (hereinafter Florin) in view of US Patent No. 4,734,858 (hereinafter Schlafly).

Further, claims 11, 29, 39, and 59 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of Zachary et al, "Technology: HP is building Gadget to Make TVs Interactive" (hereinafter Zachary).

Claims 13, 14, 17, 31, 32, 41, 42, 45, 61, and 62 also stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of US Patent No. 4,163,255 (hereinafter Pires).

Claim 27 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claim 26, and further in view of U.S. Patent No. 4,965,825 (hereinafter Harvey.).

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

## 2. Response to § 251 Rejection

The Applicants respectfully disagree that the claims identified under this rejection constitute "an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based" (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the '034 patent). The Applicant's reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the "recapture rule", which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what "aspects" the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has "crept" into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the '034 patent in certain aspects, but also narrower relative to the issued

claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system. Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

*A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. ('034 patent, column 14, lines 37-45).*

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

*Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.*

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

"fundamental narrowness", identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the '034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the '034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the '034 patent. Consider for example that the claims of the '034 patent do not include any limitations directed to enabling "the user to place an order for an item by a single action." Accordingly, the opportunity did not arise during the prosecution of the '034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issue claims of the '034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that "[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application", whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner's attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the '034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

#### 1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the original patent." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.



Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

3. Response to § 112 Rejection

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

4. Response to § 103 Rejections

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Taking claim 10 of the present reissue application as an exemplary claim for discussion purposes, the Office Action contends that "Florin does not explicitly disclose:

order the item by a single action with the client; and

wherein the enabling of the user to order the item by a single action includes 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action." (Office Action, page 6-7)

The Office Action then goes on to state that Schlafly discloses ordering of the item by a single action with the user, and points to the disclosures in Schlafly, quoted immediately below, in support of this position:

*Once the item has been specified it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent at 94 by automatic dialing of the local processor center 14. Once communication has been established, the entire content of the send memory is transmitted in a burst by*

*actuation of an internal modem (modulator/demodulator) 96 and the local center commences processing at 98. The send data is initially checked at 98 for verification of some of the data and a return is transmitted the data terminal at 100. The connection is then broken by the LPC and at 102 and the terminal goes "on hook". The message represented by the return is displayed at 104.*

(Schlafly, column 7, lines 35-47).

However, immediately preceding the above-quoted disclosure in Schlafly, the below disclosure is provided regarding actions that are required by a user:

*Operation of a data terminal 12 in the case of ordering of merchandise from various mail order suppliers is illustrated with FIGS. 3-6. FIG. 4 shows a portion 80 of a page from a Sears catalog. FIG. 5 illustrates a portion 82 of a J.C. Penney Catalog page.*

*As an example of a catalog order data entry, at 84 in FIG. 3 and after turn on, the user's individual subscriber secret personal authorization number, a four digit number for example, promptly by a word display, is entered. This is followed by sequentially occurring prompts, which permit entry of additional order key actuations in accordance with suitable accompanying operating instructions.*

*The first set of prompts at 86 calls for the entry of a code specifying the supplier by its catalog and a page number. The second set of prompts at 88 requires specification of the nature of the transaction, e.g. catalog number and special charge and shipping instructions if required. The third set of prompts at 90*

*requires entry of the quantity and options such as color and size when these are needed to properly specify the desired item.*

(Schlafly, column 7, lines 13-34).

Clearly, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order.

In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative with the disclosures provided in Florin.

Claim 1, as indicated above, has also been amended to include a limitation corresponding substantially to limitations of claims 25 and 26, claim 26 now having been cancelled. Specifically, claim 10 now recites the receiving of data at the client, the data including information to at least one of show and describe the item via the client, and an item identifier to enable the client to identify the item as currently being offered for sale. Claim 10 has also now been amended to recite that the enabling of the user to place the order for the item via the single action includes utilizing the received item identifier.

The above remarks also address the further rejections presented under 35 U.S.C. §103 against the other claims of the present reissue application. Specifically, the further independent claims each include limitations corresponding approximately to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

In light of the above, the Applicants respectfully submit that the rejections under 35 U.S.C. § 103 have been overcome, and withdrawal of these rejections is therefore respectfully requested.

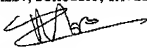
5. Conclusion

Having tendered the above remarks, and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 11/10/, 2003

  
André L. Marais  
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Docket No.: 5214P001R

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KURIACOSE JOSEPH, ET AL.

Application No.: 09/672,523

Filed: September 27, 2000

For: A METHOD AND SYSTEM TO FACILITATE  
ORDERING OF AN ITEM (AS AMENDED)

Art Group: 3621

Examiner: Alexander G. Kalinowski

## PETITION FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. § 1.136(a)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

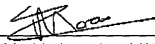
In accordance with 37 C.F.R. § 1.136(a), Applicants for the above-identified application respectfully Petition the Commissioner for a one (1) month extension of time, extending the period for response to November 10, 2003, from the Office Action dated July 09, 2003. The petition filing fee of \$110.00 and an Amendment and Response to Office Action are attached.

If it should be determined that a longer extension of time is required to prevent this application from being abandoned, please charge any additional fees to Deposit Account No. 02-2666. A copy of the Fee Transmittal is enclosed for deposit account charging purposes.

Respectfully submitted,

Blakely, Sokoloff, Taylor &amp; Zafman LLP

Date: November 10, 2003

  
André L. Marais, Reg. No. 48,095

## CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile on the date shown below to the United States Patent and Trademark Office.

  
Leslie D. Rogan

11-10-03

Date

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**OFFICIAL**Deliver to: Alexander G. Kalinowski, USPTOArt Group: 3621Facsimile No.: 703 305-7687Date: November 10, 2003From: André L. Marais, Reg. No. 48,095Our Docket No.: 52142001RNumber of pages 30 including this sheet.Application No.: 09/672,523Filing Date: 9/27/2000Docket Due Date(s): 10/9/2003 | 11/9/2003

Enclosed are the following documents:

- |                                                                             |                                                                                   |
|-----------------------------------------------------------------------------|-----------------------------------------------------------------------------------|
| <input checked="" type="checkbox"/> Amendment: _____                        | <input type="checkbox"/> Issue Fee Transmittal                                    |
| <input type="checkbox"/> Appeal Brief (in triplicate) (____pgs)             | <input type="checkbox"/> Notice of Appeal                                         |
| <input type="checkbox"/> Application: _____                                 | <input type="checkbox"/> Petition for: _____                                      |
| (____pgs) w/cover & abstract)                                               | <input type="checkbox"/> Request for Continued Examination (RCE)                  |
| <input type="checkbox"/> Assignment & Cover Sheet (____pgs)                 | <input type="checkbox"/> Reply Brief (____pgs)                                    |
| <input checked="" type="checkbox"/> Certificate of <u>Facsimile</u>         | <input type="checkbox"/> Request & Certification Under 35 USC 122(b)(2)(B)(i)     |
| <input type="checkbox"/> Continued Prosecution Application (CPA)            | <input type="checkbox"/> Request to Rescind Previous Nonpublication Request       |
| <input type="checkbox"/> Declaration & POA (____pgs)                        | <input type="checkbox"/> Response to Notice of Missing Parts & Formalities Letter |
| <input type="checkbox"/> Drawings: ____ sheets, ____ figures                | <input type="checkbox"/> Response to Written Opinion (____pgs)                    |
| <input checked="" type="checkbox"/> Extension of Time: <u>one (1) month</u> | <input type="checkbox"/> Terminal Disclaimer                                      |
| <input checked="" type="checkbox"/> Fee Transmittal (in duplicate)          | <input type="checkbox"/> Transmittal of Publication Fee Due                       |
| <input type="checkbox"/> IDS & PTO/SB/08 (____pgs)                          | <input checked="" type="checkbox"/> Transmittal Letter                            |
| <input type="checkbox"/> Other _____                                        |                                                                                   |

**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.84)**

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Leslie D. Rogan 11/10/2003  
Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kuriacose JOSEPH, et al.

Application No.: 09/672,523

Filed: September 27, 2000

For: A METHOD AND SYSTEM TO  
FACILITATE ORDERING OF AN  
ITEM (As Amended)

Examiner: Kalinowski, Alexander G.

Art Group: 3626

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on December 15, 2003  
Date of Deposit

Leslie Rogan  
Name of Person Faxing Correspondence

Leslie K. Rogan 12/15/03  
Signature Date

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450.

**RESPONSE TO THE NOTICE OF NON-COMPLIANT AMENDMENT**  
**(37 CFR 1.121)**

Sir:

In response to the Notice of Non-Compliant Amendment, mailed November 13, 2003, Applicants have below set forth the complete listing of all of the claims of the application.

**Amendments to the Claims** are reflected in the listing of claims that begins on page 2 of this paper.

**Remarks/Arguments** begin on page 13 of this paper.

Amendments to the Claims:

Please cancel claims 26 and 56, without prejudice.

Please amend the claims as follows:

1 – 9 (Cancelled)

10. (Currently Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing ~~an~~ the item to a user via the client

enabling the user to place an order ~~for~~ the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing ~~an~~ the order for the item to be placed,

wherein the enabling of the user to place the order ~~for~~ the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify the item~~ as currently being offered for sale at the time of the single action.

11. (Previously Presented) The method of claim 10, wherein the single action is one of a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.
12. (Canceled)
13. (Previously Presented) The method of claim 10, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.
14. (Previously Presented) The method of claim 10, wherein the user related, personal information is stored in memory in the client.
15. (Previously Presented) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.
16. (Previously Presented) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.
17. (Currently Amended) The method of claim ~~42~~ 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.
18. (Previously Presented) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:  
the client retrieving information from one or more of the local computer and the associated storage.

19. (Previously Presented) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Previously Presented) The method of claim 18, wherein the local computer is part of a local area network.
21. (Previously Presented) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:  
    sending information used in processing the order from the client to the central processing facility.
22. (Previously Presented) The method of claim 10, further including:  
    sending an order confirmation to the user to confirm the order.
23. (Previously Presented) The method of claim 21, further including:  
    communicating information between the client and the server via the central processing facility.
24. (Previously Presented) The method of claim 23, wherein a telephone system acts as the central processing facility.
25. (Currently Amended) The method of claim 10 including receiving at the client data including  
    ~~(a) information to at least one of show and describe the item via the client;~~  
    and  
    ~~(b)~~ information to enable the user to order the item by the single action with respect to the client.
26. (Canceled)

27. (Currently Amended) The method of claim 26 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Currently Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to the item identifier~~ information to identify the item ~~that is~~ as currently being offered for sale at the time of the single action.

30. (Canceled)

29. (Currently Amended) The method of claim 28, wherein the single action includes a at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

31. (Previously Presented) The method of claim 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

32. (Previously Presented) The method of claim 28, including retrieving the user related, personal information from a memory associated with the client.
33. (Previously Presented) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.
34. (Previously Presented) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.
35. (Previously Presented) The method of claim 34 wherein a telephone system acts as the central processing facility.
36. (Previously Presented) The method of claim 28 including providing an order confirmation to the client to confirm the order.
37. (Previously Presented) The method of claim 28 including multiplexing the provision of the information to at least one of show and describe the item and code to the client to thereby generate data for transmission to the client.
38. (Currently Amended) A computer system to order an item, the system including:  
a data receiver to receive data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;  
a data processing system to at least one of show and describe an item to a user; and  
a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause an the order for the item to be placed,

wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier identifying the item~~ that is as currently being offered for sale at the time of the single action.

39. (Previously Presented) The system of claim 38, wherein the single action includes at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

40. (Canceled)

41. (Previously Presented) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Previously Presented) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Previously Presented) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Previously Presented) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Previously Presented) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.
47. (Previously Presented) The system of claim 46, wherein the local computer controls the client.
48. (Previously Presented) The system of claim 46, wherein the local computer is part of a local area network.
49. (Previously Presented) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.
50. (Previously Presented) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.
51. (Previously Presented) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.
52. (Previously Presented) The system of claim 51 wherein a telephone system acts as the central processing facility.
53. (Currently Amended) The system of claim 38 ~~including a~~ wherein the data receiver is to receive the data including:  
~~information to at least one of show and describe the item via the client;~~  
and  
information to enable the user to order the item by the single action with respect to the client.



54. (Previously Presented) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Previously Presented) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Currently Amended) The system of claim ~~56~~ 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Currently Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and

an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,

wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to~~ the third information identifying the item ~~that is~~ as currently being offered for sale at the time of the single action.

59. (Previously Presented) The system of claim 58, wherein the single action includes at least one of a group including:  
a selecting of a single button; and  
a pressing of a single button on a TV remote control.
60. (Canceled)
61. (Previously Presented) The system of claim 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.
62. (Previously Presented) The system of claim 58, wherein the second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.
63. (Previously Presented) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.
64. (Previously Presented) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.
65. (Previously Presented) The system of claim 64 wherein a telephone system acts as the central processing facility.
66. (Previously Presented) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.
67. (Previously Presented) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and

the second information to enable the client to thereby generate data for transmission to the client.

68 – 245 (Canceled)

246. (Previously Presented) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single action with the client.

247. (Previously Presented) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single action with the client.

248. (Previously Presented) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Previously Presented) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Previously Presented) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Previously Presented) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Previously Presented) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Previously Presented) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

260. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing ~~an~~ the item to a user via the client;  
enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing ~~an~~ the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) ~~previously received information related to the item identifier to enable the client to identify the item~~ that is as currently being offered for sale at the time of the single action.

261. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.

263. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) ~~previously provided item information related to~~ the item identifier information to identify the item ~~that is~~ as currently being offered for sale at the time of the single action.

264 – 357 (Canceled)

## **REMARKS**

### **1. Summary of the Office Action**

Claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Further, claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, and 263 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 5,621,456 (hereinafter Florin) in view of US Patent No. 4,734,858 (hereinafter Schlafly).

Further, claims 11, 29, 39, and 59 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of Zachary et al, "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary).

Claims 13, 14, 17, 31, 32, 41, 42, 45, 61, and 62 also stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of US Patent No. 4,163,255 (hereinafter Pires).

Claim 27 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claim 26, and further in view of U.S. Patent No. 4,965,825 (hereinafter Harvey.).

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

## **2. Response to § 251 Rejection**

The Applicants respectfully disagree that the claims identified under this rejection constitute “an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based” (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the ‘034 patent). The Applicant’s reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; In re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the “error” requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the “recapture rule”, which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule “prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims.” Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the “error” requirement in that such a surrender is not the type of correctable “error” contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what “aspects” the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has “crept” into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as “fundamental narrowness”) despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the ‘034 patent in certain aspects, but also narrower relative to the issued



claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system. Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

*A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. ('034 patent, column 14, lines 37-45).*

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

*Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.*

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

“fundamental narrowness”, identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the ‘034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the ‘034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the ‘034 patent. Consider for example that the claims of the ‘034 patent do not include any limitations directed to enabling “the user to place an order for an item by a single action.” Accordingly, the opportunity did not arise during the prosecution of the ‘034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issue claims of the ‘034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that “[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application”, whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner’s attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the ‘034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

#### **1412.01 Reissue Claims Must Be for Same General Invention**

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent**." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.

Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

### **3. Response to § 112 Rejection**

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

### **4. Response to § 103 Rejections**

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Taking claim 10 of the present reissue application as an exemplary claim for discussion purposes, the Office Action contends that "Florin does not explicitly disclose:

order the item by a single action with the client; and

wherein the enabling of the user to order the item by a single action includes 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action." (Office Action, page 6-7)

The Office Action then goes on to state that Schlafly discloses ordering of the item by a single action with the user, and points to the disclosures in Schlafly, quoted immediately below, in support of this position:

*Once the item has been specified it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent at 94 by automatic dialing of the local processor center 14. Once communication has been established, the entire content of the send memory is transmitted in a burst by*

*actuation of an internal modem (modulator/demodulator) 96 and the local center commences processing at 98. The send data is initially checked at 98 for verification of some of the data and a return is transmitted the data terminal at 100. The connection is then broken by the LPC and at 102 and the terminal goes "on hook". The message represented by the return is displayed at 104.*

(Schlafly, column 7, lines 35-47).

However, immediately preceding the above-quoted disclosure in Schlafly, the below disclosure is provided regarding actions that are required by a user:

*Operation of a data terminal 12 in the case of ordering of merchandise from various mail order suppliers is illustrated with FIGS. 3-6. FIG. 4 shows a portion 80 of a page from a Sears catalog. FIG. 5 illustrates a portion 82 of a J.C. Penney Catalog page.*

*As an example of a catalog order data entry, at 84 in FIG. 3 and after turn on, the user's individual subscriber secret personal authorization number, a four digit number for example, promptly by a word display, is entered. This is followed by sequentially occurring prompts, which permit entry of additional order key actuations in accordance with suitable accompanying operating instructions.*

*The first set of prompts at 86 calls for the entry of a code specifying the supplier by its catalog and a page number. The second set of prompts at 88 requires specification of the nature of the transaction, e.g. catalog number and special charge and shipping instructions if required. The third set of prompts at 90*

*requires entry of the quantity and options such as color and size when these are needed to properly specify the desired item.*

(Schlafly, column 7, lines 13-34).

Clearly, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order.

In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative with the disclosures provided in Florin.

Claim 1, as indicated above, has also been amended to include a limitation corresponding substantially to limitations of claims 25 and 26, claim 26 now having been cancelled. Specifically, claim 10 now recites the receiving of data at the client, the data including information to at least one of show and describe the item via the client, and an item identifier to enable the client to identify the item as currently being offered for sale. Claim 10 has also now been amended to recite that the enabling of the user to place the order for the item via the single action includes utilizing the received item identifier.



The above remarks also address the further rejections presented under 35 U.S.C. §103 against the other claims of the present reissue application. Specifically, the further independent claims each include limitations corresponding approximately to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

In light of the above, the Applicants respectfully submit that the rejections under 35 U.S.C. § 103 have been overcome, and withdrawal of these rejections is therefore respectfully requested.

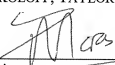
## **5. Conclusion**

Having tendered the above remarks, and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 12/15/, 2003

  
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**FACSIMILE TRANSMITTAL SHEET (TRANSMITTAL TO PTO)**

Deliver to: Examiner Kalinowski  
Firm Name: U.S. PATENT AND TRADEMARK OFFICE  
Fax Number: (703) 746-5582 Telephone No.: 703.305-2398  
From: André L. Marais  
Date: October 6, 2004 Time: 10:00 a.m. (PDT)  
Operator: Leslie Rogan (x-214) Atty Docket: 005214.P001R  
Number of pages including cover sheet: 28

US Patent Application No.: 09/672,523

Enclosed are the following documents: Response to Notice of Non-Compliant,  
Amendment, transmittal sheet and copy of OIPE stamped receipt Post Card.

Examiner Kalinowski:

Pursuant to your phone message, enclosed are the documents which you  
requested faxed to you, originally filed on April 8, 2004 along with a copy of our  
return post card date stamped April 12, 2004 by OIPE.

Please feel free to contact me if you need any further assistance.

Leslie Rogan

Blakely, Sokoloff, Taylor & Zafman

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APR 16 2004

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
LOS ANGELES

Application No.: 09/672,523 Filing Date: 9/27/2000 Docket #: 5214.P001R  
Date Mailed: 04/08/2004 Due Date(s): 04/08/2004  
Client: OPENTV, INC. Atty/Sec: ALM/LJJ/cab  
Title: A METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM (AS AMENDED)

First Named Inventor: Kuriacose Joseph*The following has been received in the U.S.P.T.O. on the date stamped hereon:*

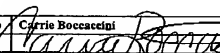
Certificate of Mailing  
Transmittal Letter  
Response to Notice of Non-Compliant Amendment  
Postcard

Assignee: OpenTV, Inc.

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application No.	09/672,523
		Filing Date	September 27, 2000
		First Named Inventor	Kuriacose Joseph
		Art Unit	3626
		Examiner Name	Alexander G. Kalinowski
Total Number of Pages in This Submission	27	Attorney Docket Number	5214P001R

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO/SB/08 <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Basic Filing Fee <input type="checkbox"/> Declaration/POA <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 5px;">         -Response to Notice of Non-Compliant Amendment          -Postcard       </div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Nathan P. Elder, Reg. No. 55,150
Signature	BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Date	4/8/04

CERTIFICATE OF MAILING/TRANSMISSION	
I hereby certify that this correspondence is being transmitted via facsimile on the date shown below to the United States Patent and Trademark Office.	
Typed or printed name	Carrie Boccacini
Signature	
Date	April 8, 2004

Based on PTO/SB/21 (2-04) as modified by Blakely, Sokoloff, Taylor & Zafman (4/8/04) 02/10/2004.  
 SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22304-1450

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/672,523

Applicant: Kuriacose JOSEPH, et al.

Filed: September 27, 2000

TC/A.U. 3626

Examiner: Kalinowski, Alexander G.

Docket No.: 5214P001R

Customer No.: 08791

Confirmation No.: 2175

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on April 8, 2004  
Date of Deposit

Carrie Boccacini  
Name of Person Faxing Correspondence

Signature

Date

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450.

**RESPONSE TO THE NOTICE OF NON-COMPLIANT AMENDMENT**  
**(37 CFR 1.121)**

Sir:

In response to the Notice of Non-Compliant Amendment, mailed March 8, 2004,  
Applicants have below set forth the complete listing of all of the claims of the  
application.

**Amendments to the Claims** are reflected in the listing of claims that begins on page 2 of  
this paper.

**Remarks/Arguments** begin on page 13 of this paper.

Amendments to the Claims:

Please cancel claims 26 and 56, without prejudice.

Please amend the claims as follows:

1 - 9 (Cancelled)

10. (Currently Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing [an] the item to a user via the client

enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing [an] the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier to enable the client to identify the item as currently being offered for sale at the time of the single action.

11. (Previously Presented) The method of claim 10, wherein the single action is one of a group including:
- selecting of a single button; and
  - pressing of a single button on a TV remote control.
12. (Canceled)
13. (Previously Presented) The method of claim 10, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.
14. (Previously Presented) The method of claim 10, wherein the user related, personal information is stored in memory in the client.
15. (Previously Presented) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.
16. (Previously Presented) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.
17. (Currently Amended) The method of claim [12] 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.
18. (Previously Presented) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:
- the client retrieving information from one or more of the local computer and the associated storage.

19. (Previously Presented) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Previously Presented) The method of claim 18, wherein the local computer is part of a local area network.
21. (Previously Presented) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:  
sending information used in processing the order from the client to the central processing facility.
22. (Previously Presented) The method of claim 10, further including:  
sending an order confirmation to the user to confirm the order.
23. (Previously Presented) The method of claim 21, further including:  
communicating information between the client and the server via the central processing facility.
24. (Previously Presented) The method of claim 23, wherein a telephone system acts as the central processing facility.
25. (Currently Amended) The method of claim 10 including receiving at the client data including  
[(a) information to at least one of show and describe the item via the client;  
and]  
[(b)] information to enable the user to order the item by the single action with respect to the client.
26. (Canceled)



27. (Currently Amended) The method of claim [26] 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Currently Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) [previously provided information related to] the item identifier information to identify the item [that is] as currently being offered for sale at the time of the single action.

30. (Canceled)

29. (Currently Amended) The method of claim 28, wherein the single action includes [a] at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

31. (Previously Presented) The method of claim 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

32. (Previously Presented) The method of claim 28, including retrieving the user related, personal information from a memory associated with the client.
33. (Previously Presented) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.
34. (Previously Presented) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.
35. (Previously Presented) The method of claim 34 wherein a telephone system acts as the central processing facility.
36. (Previously Presented) The method of claim 28 including providing an order confirmation to the client to confirm the order.
37. (Previously Presented) The method of claim 28 including multiplexing the provision of the information to at least one of show and describe the item and code to the client to thereby generate data for transmission to the client.
38. (Currently Amended) A computer system to order an item, the system including:  
    a data receiver to receive data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;  
    a data processing system to at least one of show and describe an item to a user; and  
    a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause [an] the order for the item to be placed,

wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier identifying the item [that is] as currently being offered for sale at the time of the single action.

39. (Previously Presented) The system of claim 38, wherein the single action includes at least one of a group including:

- selecting of a single button; and
- pressing of a single button on a TV remote control.

40. (Canceled)

41. (Previously Presented) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Previously Presented) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Previously Presented) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Previously Presented) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Previously Presented) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Previously Presented) The system of claim 46, wherein the local computer controls the client.

48. (Previously Presented) The system of claim 46, wherein the local computer is part of a local area network.

49. (Previously Presented) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Previously Presented) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.

51. (Previously Presented) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Previously Presented) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Currently Amended) The system of claim 38 [including a] wherein the data receiver is to receive the data including:

[information to at least one of show and describe the item via the client;  
and]

information to enable the user to order the item by the single action with respect to the client.

54. (Previously Presented) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Previously Presented) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Currently Amended) The system of claim [56] 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Currently Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and

an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,

wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the third information identifying the item [that is] as currently being offered for sale at the time of the single action.

59. (Previously Presented) The system of claim 58, wherein the single action includes at least one of a group including:  
a selecting of a single button; and  
a pressing of a single button on a TV remote control.
60. (Canceled)
61. (Previously Presented) The system of claim 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.
62. (Previously Presented) The system of claim 58, wherein the second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.
63. (Previously Presented) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.
64. (Previously Presented) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.
65. (Previously Presented) The system of claim 64 wherein a telephone system acts as the central processing facility.
66. (Previously Presented) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.
67. (Previously Presented) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and

the second information to enable to the client to thereby generate data for transmission to the client.

68 - 245 (Canceled)

246. (Previously Presented) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single action with the client.

247. (Previously Presented) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single action with the client.

248. (Previously Presented) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Previously Presented) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Previously Presented) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Previously Presented) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Previously Presented) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Previously Presented) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

254 -- 259 (Canceled)

260. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing [an] the item to a user via the client; enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing [an] the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier to enable the client to identify the item [that is] as currently being offered for sale at the time of the single action.

261. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Previously Presented) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.



263. (Currently Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) [previously provided item information related to] the item identifier information to identify the item that is as currently being offered for sale at the time of the single action.

264 – 357 (Canceled)

**REMARKS****1. Summary of the Office Action**

Claims 10, 11, 13-29, 31-39, 41-43, 45-59, 61-67, 246-253, and 260-263 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Further, claims 10, 12, 15, 16, 21-26, 28, 33-36, 38, 40, 43, 51-54, 58, 60, 63-66, 260, 262, and 263 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 5,621,456 (hereinafter Florin) in view of US Patent No. 4,734,858 (hereinafter Schlafly).

Further, claims 11, 29, 39, and 59 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of Zachary et al, "Technology: HP is building Gadget to Make TVS Interactive" (hereinafter Zachary).

Claims 13, 14, 17, 31, 32, 41, 42, 45, 61, and 62 also stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10, 28, 38 and 58, and further in view of US Patent No. 4,163,255 (hereinafter Pires).

Claim 27 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claim 26, and further in view of U.S. Patent No. 4,965,825 (hereinafter Harvey.).

Claims 18-20 and 46-48 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Florin and Schlafly, as applied to claims 10 and 38, and further in view of US Patent No. 4,789,895 (hereinafter Mustafa).

**2. Response to § 251 Rejection**

The Applicants respectfully disagree that the claims identified under this rejection constitute "an improper recapture of broadened claimed subject matter surrendered in the application for the patent on which the present reissue is based" (Office Action, page 2). The Applicants respectfully disagree that any broadening aspects of the reissue claims are related to subject matter that the Applicants previously surrendered, during the prosecution of U.S. Patent No. 5,819,034 (the '034 patent). The Applicant's reasons in connection with this position are set out more fully below.

A failure of a patentee (or a patentee's attorney) to appreciate the full scope of the invention during the prosecution of the original patent application is well recognized as an error correctable by a broadening reissue. See Amos, 953 F.2d at 616, 21 USPQ2d at 1273; in re Wilder, 736 F.2d 1516, 1519, 222 USPQ 369, 371 (Fed. Cir. 1984). This form of error has generally been accepted as sufficient to satisfy the "error" requirement of § 251. See Clement, 131 F.3d at 1468, 45 USPQ2d at 1163; Wilder, 736 F.2d at 1519, 222 USPQ at 371.

Broadening reissues are subject to the "recapture rule", which is discussed in Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The recapture rule "prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. The rule is rooted in the "error" requirement in that such a surrender is not the type of correctable "error" contemplated by the reissue statute. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1525.

The Federal Circuit, in Clement, 131, F. 3d 1464, 1468-70, 45 USPQ2 at 1161, 1163-65 (Fed. Cir. 1997), stated that an analysis under the recapture rule includes a four-step analysis, namely:

1. Determining whether and in what "aspects" the reissue claims are broader than the claims of the issued patent. A reissue claim that does not include a limitation present in the original patent claims is broader in that respect. See id.
2. Determining whether the broader aspects of the reissue claims relate to surrendered subject matter. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." See id. at 1469, 45 USPQ2d at 1164.
3. Determining whether the surrendered subject matter has "crept" into the reissue claims.
4. Determining whether the reissue claims are materially narrowed, relative to the claims of the issued patent, in other respects, with a view to determining whether the recapture may be avoided. For example, in Ball Corp. v. United States, the recapture rule was avoided because the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadened aspects of the claims. 729 F.2d at 1438, 221 USPQ at 296.

Applying the above discussed analysis under the recapture rule to the claims of the present reissue application, it is apparent that the reissue claims are broader than the issued claims of the '034 patent in certain aspects, but also narrower relative to the issued

claims in other respects. Specifically the claims of the present reissue application are directed to facilitating ordering an item using a distributed computer system. Accordingly, limitations of at least the independent claims of the present reissue application are absent from the independent claims of the '034 patent. Consider, for example, the first limitation of independent claim one of the '034 patent, which requires the following:

*A source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted. ('034 patent, column 14, lines 37-45).*

Clearly, claim 10 of the present reissue application does not include a limitation corresponding to the above-identified limitation of claim 1 of the '034 patent, and claim 10 of the present reissue application is accordingly broader in this respect.

On the other hand, consider the following limitation of claim 10 of the reissue claims:

*Enabling the user to place an order for the item with a single action with respect to the client, while the item is being offered for sale, the single action being in connection with the order.*

The issued claims of the '034 patent do not include a limitation corresponding to the above-identified limitation of claim 10 of the reissue application. In this respect, claim 10 of the reissued claims has been materially narrowed, relative to the claims of the '034 patent. The Applicants believe that this constitutes what is identified as a

"fundamental narrowness", identified in Ball Corp., which avoids the recapture rule, despite broadened aspects of the claims.

Further, as limitations of the issued claims of the '034 patent are not present in the reissue claims, the Applicants believe that the broader aspects of the reissue claims (i.e., the aspects corresponding to limitations in the '034 patent that are absent in the independent claims of the current reissue application) do not relate to surrendered subject matter. This is because the Applicants could not, by way of argument or amendment, surrender subject matter corresponding to the limitations of the present reissue claims in view of the absence of these limitations from the issued claims of the '034 patent. Consider for example that the claims of the '034 patent do not include any limitations directed to enabling "the user to place an order for an item by a single action." Accordingly, the opportunity did not arise during the prosecution of the '034 patent for the Applicants to in fact surrender subject matter pertaining to this limitation. In short, the subject matter of the independent claims of the current reissue application is different from the subject matter of the issue claims of the '034 patent, and the question of recaptured subject matter does not arise. This dovetails with the above position that the reissue claims are sufficiently narrowed, despite the broadened aspects of the claims, so as to avoid the recapture rule.

In conclusion, the Applicants believe that the rejection under 35 U.S.C. § 251 has been fully addressed, and withdrawal of this rejection is requested.

The Applicants note that the Office Action states that "[a]t a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,098 application", whereafter the limitations of the identified independent claims are listed (Office Action, pages 3-5). The Applicants fail to fully understand the reason for this alleged requirement. The Applicants also draw the Examiner's attention to the co-pending divisional reissue application serial number 09/903,458, in which claims corresponding to the issued claims of the '034 patent are presented. It will be recalled that, on the

suggestion of the Examiner, a number of divisional reissue applications were filed based off the current reissue application, each of these divisional applications including claims that were originally included in the current reissue application. Claims corresponding to the claims of the divisional reissue applications were then cancelled from the current reissue application, by way of a preliminary amendment dated April 13, 2001.

By requiring that a limitation in the claims of the '034 be present in the claims of the present reissue application, we speculate that reference is being made to the "original invention" requirement. We below quote the pertinent section (1412.01) from the MPEP:

#### **1412.01 Reissue Claims Must Be for Same General Invention**

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does not mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same invention as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the original patent." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if

the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

(MPEP 1412.01, Emphasis Added)

The claims of the present reissue application are clearly described in the original patent specification for the '034 patent, and are likewise enabled by the original patent specification for the '034 patent, such that 35 U.S.C. § 112, first paragraph, is satisfied.



Further, there is nothing in the original patent specification for the '034 patent which indicates an intent not to claim the subject matter of the claims of the present reissue application.

In short, the Applicants do not believe that a limitation from the issued independent claims of the '034 patent is required within the independent claims of the present reissue application in order to satisfy the "original invention" requirement.

3. Response to § 112 Rejection

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

The Examiner is thanked for identifying this error in the dependency of claim 17. The Applicants have amended claim 17 to be dependent upon claim 10, as correctly assumed by the Examiner.

4. Response to § 103 Rejections

The Applicants respectfully traverse these rejections for the reasons set out below, and ask the Examiner for reconsideration. The Applicants have further also slightly amended the claims to define clearly the intended import of the claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Taking claim 10 of the present reissue application as an exemplary claim for discussion purposes, the Office Action contends that "Florin does not explicitly disclose:

order the item by a single action with the client; and

wherein the enabling of the user to order the item by a single action includes 1) previously stored user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related personal information each time a further order is placed and 2) previously received information related to the item being offered for sale at the time of the single action." (Office Action, page 6-7)

The Office Action then goes on to state that Schlafly discloses ordering of the item by a single action with the user, and points to the disclosures in Schlafly, quoted immediately below, in support of this position:

*Once the item has been specified it can be reviewed and modified or it can be stored in a send memory at 92 and later caused to be sent at 94 by automatic dialing of the local processor center 14. Once communication has been established, the entire content of the send memory is transmitted in a burst by*

*actuation of an internal modem (modulator/demodulator) 96 and the local center commences processing at 98. The send data is initially checked at 98 for verification of some of the data and a return is transmitted the data terminal at 100. The connection is then broken by the LPC and at 102 and the terminal goes "on hook". The message represented by the return is displayed at 104.*

(Schlafly, column 7, lines 35-47).

However, immediately preceding the above-quoted disclosure in Schlafly, the below disclosure is provided regarding actions that are required by a user:

*Operation of a data terminal 12 in the case of ordering of merchandise from various mail order suppliers is illustrated with FIGS. 3-6. FIG. 4 shows a portion 80 of a page from a Sears catalog. FIG. 5 illustrates a portion 82 of a J.C. Penney Catalog page.*

*As an example of a catalog order data entry, at 84 in FIG. 3 and after turn on, the user's individual subscriber secret personal authorization number, a four digit number for example, promptly by a word display, is entered. This is followed by sequentially occurring prompts, which permit entry of additional order key actuations in accordance with suitable accompanying operating instructions.*

*The first set of prompts at 86 calls for the entry of a code specifying the supplier by its catalog and a page number. The second set of prompts at 88 requires specification of the nature of the transaction, e.g. catalog number and special charge and shipping instructions if required. The third set of prompts at 90*

*requires entry of the quantity and options such as color and size when these are needed to properly specify the desired item.*

(Schlafly, column 7, lines 13-34).

Clearly, the ordering of an item, as disclosed in Schlafly, requires more than a single action with respect to the client. Specifically, to perform a catalogue order utilizing the system and methodology disclosed in Schlafly, a user is required to provide an individual subscriber secret personal authorization number, which is followed by sequentially occurring prompts responsive to which the user enters a code specifying a supplier by a catalogue and page number, the nature of the transaction, and the quantity and options pertaining to the relevant order.

In short, Schlafly simply does not disclose placing an order for an item by a single action with respect to a client, but instead clearly discloses a sequence of actions. Schlafly is accordingly cumulative with the disclosures provided in Florin.

Claim 1, as indicated above, has also been amended to include a limitation corresponding substantially to limitations of claims 25 and 26, claim 26 now having been cancelled. Specifically, claim 10 now recites the receiving of data at the client, the data including information to at least one of show and describe the item via the client, and an item identifier to enable the client to identify the item as currently being offered for sale. Claim 10 has also now been amended to recite that the enabling of the user to place the order for the item via the single action includes utilizing the received item identifier.

The above remarks also address the further rejections presented under 35 U.S.C. §103 against the other claims of the present reissue application. Specifically, the further independent claims each include limitations corresponding approximately to those of claim 10. The dependent claims are deemed to include all limitations of claims from which they depend, and the above remarks similarly address the rejections presented under 35 U.S.C. §103 against these dependent claims.

In light of the above, the Applicants respectfully submit that the rejections under 35 U.S.C. § 103 have been overcome, and withdrawal of these rejections is therefore respectfully requested.

#### 5. Conclusion

Having tendered the above remarks, and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact André Marais at (408) 947-8200 ext. 204.

Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 4/8, 2004

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Attorney's Docket No. 5214P001R

Patent

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kuriacose JOSEPH, et al.

Application No.: 09/672,523

Filed: September 27, 2000

For: A METHOD AND SYSTEM TO  
FACILITATE ORDERING OF AN ITEM  
(As Amended)

Examiner: Kalinowski, Alexander G.

Art Group: 3626

I hereby certify that this correspondence is being  
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Washington, D.C. 20231on February 20, 2003  
Date of Deposit

Leslie Rogan

Name of Person Mailing Correspondence

Signature

Date

Assistant Commissioner for Patents  
Washington, D.C. 20231PRELIMINARY AMENDMENT AND RESPONSE TO FINAL OFFICE ACTION

Sir:

In response to the Final Office Action mailed November 20, 2002,  
Applicants respectfully request the Examiner to enter the following amendments  
and to consider the following remarks.

IN THE CLAIMS:

Please amend the claims as follows:

VERSION OF CLAIMS WITH MARKINGS

✓ ✓  
Please cancel claims 12, 30, 40, 60, and 278-281, without prejudice.

10. (Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

at least one of showing and describing an item to a user via the client;

enabling the user to order the item by a single [interaction] action with respect to the client, the single action being in connection with the order; and

in response to the single [interaction] action with respect to the client, causing an order for the item to be placed[.],

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) previously received information related to the item being offered for sale at the time of the single action.

11. (Amended) The method of claim 10, wherein the single [interaction] action is one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

12. (Canceled) The method of claim 10, wherein causing the order to be placed is achieved by using:

information related to the item; and  
user related personal information.

13. (Amended) The method of claim [12] 10, wherein the user related personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

14. (Amended) The method of claim [12] 10, wherein the user related personal information is stored in memory in the client.

15. (Unamended) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.

16. (Unamended) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.

17. (Amended) The method of claim 12, wherein the client is associated with at least a set top box, and wherein the user related personal information is stored at the set top box.

18. (Unamended) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:



the client retrieving information from one or more of the local computer and the associated storage.

19. (Unamended) The method of claim 18, wherein the method further includes:

controlling the client by means of the local computer.

20. (Unamended) The method of claim 18, wherein the local computer is part of a local area network.

21. (Unamended) The method of claim 10, wherein the system further includes a central processing facility in communication with the server and wherein the method includes:

sending information used in processing the order from the client to the central processing facility.

22. (Unamended) The method of claim 10, further including:

sending an order confirmation to the user to confirm the order.

23. (Unamended) The method of claim 21, further including:

communicating information between the client and the server via the central processing facility.

25. (Unamended) The method of claim 23, wherein a telephone system acts as the central processing facility.

25. (Amended) The method of claim 10 including receiving at the client data including:

(c) information to at least one of show and describe the item via the client; and

(d) information to enable the user to order the item by the single [interaction] action with respect to the client.

26. (Unamended) The method of claim 25 wherein the data further includes an item identifier to identify the item.

27. (Unamended) The method of claim 26 wherein the item identifier includes at least one of a group of identifiers including a code and a command.

28. (Amended) A method of facilitating ordering an item, the method including:

providing a client with information to at least one of show and describe an item to a user; and

enabling the user to order the item by a single [interaction] action with respect to the client[.], the single action being in connection with the order, wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) previously provided item information related to the item that is being offered for sale at the time of the single action.

29. (Amended) The method of claim 28, wherein the single [interaction] action includes a least one of a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

30. (Canceled) The method of claim 28, including receiving the order from the client, the order including:  
information related to the item; and  
user related personal information.

31. (Amended) The method of claim [30] 28, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

32. (Amended) The method of claim [30] 28, including retrieving the user related, personal information from a memory associated with the client.

33. (Amended) The method of claim 28, including providing the information to at least one of show and describe the item in the form of a television signal.

34. (Unamended) The method of claim 28 including communicating with a central processing facility and wherein the client sends the order to the central processing facility for receipt via a transceiver.

35. (Unamended) The method of claim 34 wherein a telephone system acts as the central processing facility.

36. (Unamended) The method of claim 28 including providing an order confirmation to the client to confirm the order.

37. (Amended) The method of claim ~~24~~ 28 including multiplexing the provision of the information to at least one of show and describe the item and [the] code to the client to thereby generate data for transmission to the client.

38. (Amended) A computer system to order an item, the system including:  
a data processing system to at least one of show and describe an item to a user; and

a client to enable the user to order the item by a single [interaction] action with respect to the client and, in response to the single [interaction] action, to cause an order for the item to be placed[.].

wherein the client is to enable the user to order the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) previously received information related to the item that is being offered for sale at the time of the single action.

39. (Amended) The system of claim 38, wherein the single [interaction] action includes at least one of a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

40. (Canceled) The system of claim 38, wherein the client is to place the order using:

information related to the item; and  
user related personal information.

41. (Amended) The system of claim [40] ~~38~~, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Amended) The system of claim [40] ~~38~~, wherein the user related, personal information is stored in memory of the client.

43. (Amended) The system of claim 38, wherein the [distributed computing] computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

45. (Amended) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Unamended) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.

47. (Unamended) The system of claim 46, wherein the local computer controls the client.

48. (Unamended) The system of claim 46, wherein the local computer is part of a local area network.

49. (Unamended) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.

50. (Unamended) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.

51. (Unamended) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.

52. (Unamended) The system of claim 51 wherein a telephone system acts as the central processing facility.

53. (Amended) The system of claim 38 including a data receiver to receive data including:

information to at least one of show and describe the item via the client;

and

information to enable the user to order the item by (a) the single [interaction] action with respect to the client.

54. (Amended) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a packet data extractor to extract the information to enable from the data.

55. (Amended) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Unamended) The system of claim 53 wherein the data further includes an item identifier to identify the item.

57. (Unamended) The system of claim 56 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58. (Amended) A computer system to facilitate ordering an item, the system including:

a data source to provide a client with first information to at least one of show and describe an item to a user; and

an information source to provide the client with second information to enable the user to order the item by a single [interaction] action with respect to the client[.].

wherein the client is to enable the user to order the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal

information each time a further order is placed and (2) previously received information related to the item that is being offered for sale at the time of the single action.

59. (Amended) The system of claim 58, wherein the single [interaction] action includes at least one of a group including:
- a selecting of a single button; and
  - a pressing of a single button on a TV remote control.

60. (Canceled) The system of claim 58, including a data receiver to receive the order from the client, the order including:
- information related to the item; and
  - user related personal information.

61. (Amended) The system of claim [60] 58, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

62. (Amended) The system of claim [60] 58, wherein the [code is] second information includes code executable by the client to retrieve the user related, personal information from a memory associated with the client.

63. (Unamended) The system of claim 58, wherein the data source is to provide the information in the form of a television signal.



64. (Unamended) The system of claim 58 including a data transceiver to communicate with a central processing facility and wherein the client sends the order to the central processing facility for receipt via the data transceiver.

65. (Unamended) The system of claim 64 wherein a telephone system acts as the central processing facility.

66. (Unamended) The system of claim 58 wherein the data source is to provide an order confirmation to the client to confirm the order.

*D12*  
67. (Amended) The system of claim 58 including a multiplexer to multiplex the provision of the first information to at least one of show and describe and the second information to enable to the client to thereby generate data for transmission to the client.

*D13*  
246. (Amended) The method of claim 25 wherein the information to enable includes code executable by the client to enable the user to order the item by the single [interaction] action with the client.

*F1*  
247. (Amended) The method of claim 25 wherein the information to enable includes data to be processed by code executable by the client to enable the user to order the item by the single [interaction] action with the client.

248. (Unamended) The method of claim 28 wherein the enabling includes providing code to enable the user to order the item.

249. (Unamended) The method of claim 28 wherein the enabling includes providing data to be processed by code to enable the user to order the item.

250. (Unamended) The system of claim 53 wherein the information to enable includes code to enable the user to order the item.

251. (Unamended) The system of claim 53 wherein the information to enable includes data to be processed by code to enable the user to order the item.

252. (Amended) The system of claim 58 wherein the second information to enable includes code to be executed by the client to enable the user to order the item.

253. (Amended) The system of claim 58 wherein the information to enable includes data to be processed by code to enable the user to order the item.

260. (Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate [facilitating] ordering an item within a distributed computing system including at least one client and at least one server by:

at least one of showing and describing an item to a user via the client;  
enabling the user to order the item by a single [interaction] action with respect to the client the single action being in connection with the order[: and],  
in response to the single [interaction] action with respect to the client,  
causing an order for the item to be placed[.].

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is

DIS  
Contd  
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stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) previously received information related to the item that is being offered for sale at the time of the single action.

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261. (Unamended) The machine-readable medium of claim 260, wherein the medium includes a data stream.

262. (Unamended) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.

263. (Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate [facilitating] ordering an item by:

providing a client with information to at least one of show and describe an item to a user; and

enabling the user to order the item by a single [interaction] action with respect to the client[,], the single action being in connection with the order,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) previously provided item information related to the item that is being offered for sale at the time of the single action.

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278. (Canceled) A method of facilitating ordering using a distributed computing system including at least one client and at least one server, the method including:

at least one of showing and describing an offering to a user via the client;  
enabling the user to order the offering by a single interaction with the client; and  
in response to the single interaction with the client causing an order related to the offering to be placed.

279. (Canceled) A method including:

providing a client with information to at least one of show and describe an offering to a user; and  
enabling the user to order the offering by a single interaction with the client.

280. (Canceled) A computer system including:

a data processing system to at least one of show and describe an offering to a user; and  
a client to enable the user to order the item by a single interaction with the client and, in response to the single interaction, to cause an order for the offering to be placed.

281. (Canceled) A computer system including:

a data source to provide a client with information to at least one of show and describe an offering to a user; and

an information source to provide the client with information to enable the user to order the offering by a single interaction with the client.

Approved for use through 10/31/2005. CMB 081-0011  
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# REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Address to:  
Commissioner for Patents  
BOX RCE  
Washington, DC 20231

Application No.	09/672,523
Filing Date	September 27, 2000
First Named Inventor	Kuriacose Joseph
Group Art Unit	3626
Examiner Name	Alexander G. Kalinowski
Attorney Docket Number	5214P001R

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR § 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

## 1. Submission required under 37 C.F.R. § 1.114

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on (Any unamended amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other Preliminary Amendment

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 02-2666.
- i. ☒ RCE fee required under 37 C.F.R. § 1.17(e) and any additional claims fee(s)
- ii. ☐ Extension of time fee (37 C.F.R. § 1.138 and 1.17)
- iii. ☐ Other: (\$0.00)
- b. ☒ Check in the amount of \$750.00 enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	André L. Marais	Registration No. (Attorney/Agent)	48,095
Signature		Date	February 20, 2003

## CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail with sufficient postage in an envelope addressed to: Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231 on:

February 20, 2003

Name (Print/Type)	Leslie D. Rogan	Date	February 20, 2003
Signature			

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**FACSIMILE TRANSMITTAL SHEET (TRANSMITTAL TO PTO)**

Deliver to: Examiner Kalinowski  
Firm Name: U.S. PATENT AND TRADEMARK OFFICE  
Fax Number: (703) 746-5582 Telephone No.: 703.305-2398  
From: André L. Marais  
Date: March 18, 2003 Time: 2:00 p.m. (PST)  
Operator: Leslie Rogan (x-214) Atty Docket: 005214.P001R  
Number of pages including cover sheet: 66 *(part 1 of 2)*

US Patent Application No.: 09/672,523

Enclosed are the following documents: Request for Continued Examination,  
Fee Transmittal, Preliminary Amendment and Response to Final Office Action  
And Response to the Notice of Non-Compliant Amendment

Examiner Kalinowski:

Pursuant to your request, enclosed are the documents which were filed  
on February 20, 2003.  
As mentioned in the voice mail message I left for you, I will be sending  
this in two batches as our fax machine cannot process all the documents at once.  
Please feel free to contact me or André if you need any further assistance.  
Leslie Rogan  
Assistant to André L. Marais

**CONFIDENTIALITY NOTE**

The documents accompanying this facsimile transmission contain information from the law firm of Blakely Sokoloff Taylor & Zafman LLP that is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution, or use of the contents of this faxed information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

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PLEASE CALL (408) 947-8200 AND ASK FOR THE OPERATOR NAMED ABOVE.**

**FEE TRANSMITTAL  
for FY 2003**

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 750.00

**Complete if Known**

Application Number 09/672,523  
 Filing Date September 27, 2000  
 First Named Inventor Kuriacose Joseph  
 Examiner Name Alexander G. Kalnowski  
 Group/Art Unit 3626  
 Attorney Docket No. 5214P001R

**METHOD OF PAYMENT (check one)**

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None  
☒ Deposit Account

Deposit Account Number

02-2666

Deposit Account Name

Blakely, Sokoloff, Taylor &amp; Zafman LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments  
☒ Charge any additional fee(s) required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

**FEE CALCULATION****BASIC FILING FEE**

Large Entity	Fee Code	Fee (\$)	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	750	2001	375	Utility filing fee			
1002	330	2002	165	Design filing fee			
1003	520	2003	260	Plant filing fee			
1004	750	2004	375	Reissue filing fee			
1005	160	2005	80	Provisional filing fee			
SUBTOTAL (1)						(3)	

**EXTRA CLAIM FEES**

Large Entity	Fee Code	Fee (\$)	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1201	54	2201	27	Claims in excess of 20			
1202	54	2202	27	Independent claims in excess of 3			
1203	280	2203	140	Multiple Dependent claims, if not paid			
1204	54	2204	27	Resubmitted independent claims over original patent			
1205	18	2205	9	Resubmitted claims in excess of 20 and over original patent			
SUBTOTAL (2)						(5)	0.00

Large Entity	Fee Code	Fee (\$)	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1302	19	2302	9	Claims in excess of 20			
1301	54	2301	27	Independent claims in excess of 3			
1303	280	2303	140	Multiple Dependent claims, if not paid			
1304	54	2304	27	Resubmitted independent claims over original patent			
1305	18	2305	9	Resubmitted claims in excess of 20 and over original patent			
SUBTOTAL (3)						(5)	0.00

\*If number previously paid, \$990.00. For Resubmissions, see below.

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity	Fee Code	Fee (\$)	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath			
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet			
2053	130	2053	65	Non-English specification			
1812	2,520	1812	1,260	For filing a request for ex parte reexamination			
1804	920*	1804	920*	Requesting publication of SIIR prior to Examiner action			
1805	1,840*	1805	1,840*	Requesting publication of SIIR after Examiner action			
1205	110	2251	55	Extension for reply within first month			
1252	410	2252	205	Extension for reply within second month			
1363	930	2253	465	Extension for reply within third month			
1254	1,450	2254	725	Extension for reply within fourth month			
1255	1,970	2255	985	Extension for reply within fifth month			
1404	305	2401	150	Notice of Appeal			
1402	330	2402	160	Filing a brief in support of an appeal			
1403	280	2403	140	Request for oral hearing			
1451	1,510	2451	1,510	Petition to institute a public use proceeding			
1452	110	2452	55	Petition to revise - unrevokable			
1453	1,300	2453	650	Petition to revise - unconditional			
1501	1,300	2501	650	Utility issue fee (or reissue)			
1502	470	2502	235	Design issue fee			
1503	630	2503	315	Plant issue fee			
1460	130	3460	130	Petitions to the Commissioner			
1607	50	1607	50	Prosecuting fee under 37 CFR 1.17(c)			
1809	180	1809	180	Disclosure of information Disclosure Sheet			
8021	40	8021	40	Recording each patent assignment per property (times number of properties)			
1009	750	1009	375	Filing a submission after final rejection (37 CFR § 1.126(a))			
1610	750	2810	375	For each additional invention to be examined (37 CFR § 1.126(b))			
1801	750	2801	375	Request for Continued Examination (RCE)			
1802	900	1802	900	Request for expedited examination of a design application			750.00
Other fee (specify)							
*Reduced by Basic Filing Fee Paid							
SUBTOTAL (5)						(5)	750.00

**SUBMITTED BY**

Name (Print/Type)

André L. Marais

Registration No.  
(Attorney/Agent)

48,095

**Complete if applicable**

Telephone

(408) 947-8200

Signature

[Signature]

Date

02/20/03

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to be used by the USPTO to process an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 15 minutes to complete, including gathering, preparing, and submitting the complete application to the USPTO. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden should be sent to the Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al.

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Docket No.: 2050.001US3

Filed: September 27, 2000

Examiner: Alexander G. Kalinowski

Serial No.: 09/672,523

Due Date: May 14, 2005

Group Art Unit: 3626

**MS Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ A Response to Notice of Non-Compliant Amendment (7 pgs.).
- ☒ Petition for Extension of Time (1 pg.), including authorization to charge Deposit Account 19-0743 in the amount of \$450.00 to cover the Extension of Time Fee.
- ☒ A return postcard.

Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

Customer Number 44367

By: 

Atty: Andre L. Marais

Reg. No. 48,095

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 28 day of April, 2005.

Name

Peter Rebuffoni

Signature

Peter Rebuffoni

S/N 09/672,523

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al.

Examiner: Alexander G. Kalinowski

Serial No.: 09/672,523

Group Art Unit: 3626

Filed: September 27, 2000

Docket No.: 2050.001US3

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This responds to the Notice of Non-Compliant Amendment mailed on February 14, 2005. In compliance with 37 CFR 1.173(b), applicants submit the following corrected "IN THE CLAIMS" section from Applicants' previously-submitted Amendment and Response filed December 15, 2003. Only the claims currently being amended are submitted with this response.

This response is accompanied by a Petition, as well as the appropriate fee, to obtain a 2-month extension of the period for responding to the Notice of Non-Compliant Amendment, thereby moving the deadline for response from March 14, 2005 to April 14, 2005.



### IN THE CLAIMS

Please amend the claims as follows:

10. (Twice Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing [an] the item to a user via the client

enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing [an] the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier to enable the client to identify the item as currently being offered for sale at the time of the single action.

17. (Twice Amended) The method of claim [12] 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

25. (Amended) The method of claim 10 including receiving at the client data including  
[(a) information to at least one of show and describe the item via the client; and]  
[(b)] information to enable the user to order the item by the single action with respect to the client.
27. (Amended) The method of claim [26] 10 wherein the item identifier includes at least one of a group of identifiers including a code and a command.
28. (Twice Amended) A method of facilitating ordering an item, the method including:  
providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale;  
and  
enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,  
  
wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) [previously provided item information related to] the item identifier information to identify the item [that is] as currently being offered for sale at the time of the single action.
29. (Twice Amended) The method of claim 28, wherein the single action includes [a] at least one of a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

38. (Twice Amended) A computer system to order an item, the system including:  
a data receiver to receive data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;  
a data processing system to at least one of show and describe an item to a user;  
and  
a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause [an] the order for the item to be placed,  
wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier identifying the item [that is] as currently being offered for sale at the time of the single action.
57. (Amended) The system of claim [56] 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.
58. (Twice Amended) A computer system to facilitate ordering an item, the system including:  
a data source to provide a client with first information to at least one of show and describe an item to a user, and third information to identify the item as currently being offered for sale; and  
an information source to provide the client with second information to enable the user to place an order for the item by a single action with respect to the client,  
wherein the client is to enable the user to place the order for the item, while being offered for sale, by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further

order is placed and (2) [previously received information related to] the third information identifying the item [that is] as currently being offered for sale at the time of the single action.

260. (Twice Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving data, at the client, the data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

at least one of showing and describing [an] the item to a user via the client; enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing [an] the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) [previously received information related to] the item identifier to enable the client to identify the item [that is] as currently being offered for sale at the time of the single action.

263. (Twice Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item by:

providing a client with information to at least one of show and describe an item to a user, and with an item identifier to identify the item as currently being offered for sale; and

enabling the user to place an order for the item by a single action with respect to the client, the single action being in connection with the order,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed, and (2) [previously provided item information related to] the item identifier information to identify the item [that is] as currently being offered for sale at the time of the single action.

**CONCLUSION**

In accordance with 37 CFR 1.173(b), only the non-compliant section of Applicants' previously-submitted Amendment and Response has been included in this response.

Claims 10, 17, 25, 27-29, 38, 53, 57-58, 260 and 263 are currently amended. Claims 1-9, 12, 26, 30, 40, 44, 56, 60, 68-245, 254-259 and 264-357 were previously canceled and no new claims are being added; as a result, claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253 and 260-263 are pending in this application.

Applicants respectfully request that the Examiner withdraw the non-compliant status and examine the claims as appropriate.

The Examiner is invited to telephone Applicants' attorney at 408-333-9972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KURIACOSE JOSEPH ET AL.

By their Representatives,

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Date 06/28/05

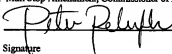
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Peter Poluph

Name



Signature



AUG 06 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1FJ  
3625

Applicant: Kurgacose Joseph et al.

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Docket No.: 2050.001US3

Serial No.: 09/672,523

Filed: September 27, 2000

Due Date: August 3, 2007

Examiner: Yogesh C. Garg

Group Art Unit: 3625

**MS Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

☒ Amendment and Response (14 pgs.).

☒ Return postcard.

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

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By: /Elena Dreszer/

Atty: Elena B. Dreszer

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Peter Reburian  
Name

[Signature]  
Signature



**S/N 09/672,523**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Kuriacose Joseph et al.	Examiner:	Yogesh C. Garg
Serial No.:	09/672,523	Group Art Unit:	3625
Filed:	September 27, 2000	Docket No.:	2050.001US3
Title:	METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM		

**AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This responds to the Office Action mailed on May 3, 2007. Please amend the above-identified patent application as follows.

### **IN THE CLAIMS**

Please amend claims 10, 21-22, 27, 33, 38, 63, and 260 as follows:

10. (Thrice Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:

receiving, via a data stream from the server, item data[, at the client], the item data including information to at least one of show and describe the item via the client and an item identifier [to enable the client] to identify the item as currently being offered for sale;

presenting [at least one of showing and describing] at least a portion of the item data to a user [via the client];

receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data;

responding to the single action by:

retrieving personal information of the user from a permanent memory in the client, and

combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and

transmitting the order for the item from the client.

[enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order; and

in response to the single action with respect to the client, causing the order for the item to be placed,

wherein the enabling of the user to place the order for the item by the single action includes using (1) previously stored, user related personal information that is stored in a memory

associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) the item identifier to enable the client to identify the item as currently being offered for sale at the time of the single action.]

21. (Amended) The method of claim 10, wherein the distributed computer system further includes a central processing facility in communication with the server and wherein the method includes:

sending information used in processing the order from the client to the central processing facility.

22. (Amended) The method of claim 10, further including:

[sending] receiving an order confirmation at the client [to the user to confirm the order].

27. (Twice Amended) The method of claim 10 wherein the item [identifier] data includes at least one of a group of identifiers including a code and a command.

33. (Amended) The method of claim [28] 10, wherein the receiving of the item data via the data stream from the server, comprises receiving the item data via [data including providing the information to at least one of show and describe the item in the form of] a television signal.

38. (Thrice Amended) A computer system to order an item, the system including:

a data receiver to receive, via a data stream from a server, item data, the item data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;

a data processing system to present at least a portion of the item data [one of show and describe an item] to a user;

an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data; and

an event processing module to respond to the single action by:  
retrieving personal information of the user from a permanent memory in the  
client, and  
combining the item data previously received via the data stream from the server  
with the personal information of the user previously stored in the permanent memory in the  
client to generate an order for the item, and  
transmitting the order for the item from the client.

[a client to enable the user to place an order for the item by a single action with respect to the client while the item is being offered for sale and, in response to the single action, to cause the order for the item to be placed,  
wherein the client is to enable the user to place the order for the item by the single action using (1) previously stored, user related, personal information that is stored in a memory for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) the item identifier identifying the item as currently being offered for sale at the time of the single action.]

63. (Amended) The system of claim [58] 38, wherein the data stream [source] is [to provide the information] in the form of a television signal.

260. (Thrice Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving, from a server, item data, the item data[, at the client, the data] including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;  
presenting at least a portion of the item data [one of show and describe an item to a user via the client];

receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data; and

responding to the single action by:  
retrieving personal information of the user from a permanent memory in the  
client, and  
combining the item data previously received from the server with the personal  
information of the user previously stored in the permanent memory in the client to generate an  
order for the item, and  
transmitting the order for the item from the client.

[enabling the user to place an order for the item by a single action with respect to the client while the item is being offered for sale, the single action being in connection with the order,

in response to the single action with respect to the client, causing the order for the item to be placed,

wherein the enabling of the user to order the item by the single action includes using (1) previously stored, user related, personal information that is stored in a memory associated with the client for repeated use in enabling further orders for further items to be placed and so that it is not necessary to solicit the user related, personal information each time a further order is placed and (2) the item identifier to enable the client to identify the item as currently being offered for sale at the time of the single action.]

### **REMARKS**

This responds to the Office Action mailed on May 3, 2007.

Claims 10, 21-22, 27, 33, 38, 63, and 260 are amended, claims 25, 28-29, 31-32, 34-37, 58-59, 61-62, 64-67, 246-253 are currently canceled, claims 1-9, 12, 26, 30, 40, 44, 56, 60, 68-245, 254-259 and 264-357 were previously canceled, and no claims are added; as a result, claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260-262 are now pending in this application.

#### **§251 Rejection of the Claims**

Claims 10-11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253, 260-263 were rejected under 35 U.S.C. § 251 as being based upon new matter. A rejection under 35 U.S.C. § 251 is appropriate "If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings," as stated in MPEP 2163.06. It is submitted that no new matter was introduced in the abstract, the specification, or the drawings and therefore the rejection under 35 U.S.C. § 251 is not proper. It is respectfully requested that the rejection be withdrawn.

#### **§112 Rejection of the Claims**

Claims 10, 11, 13-25, 27-29, 31-39, 41-43, 45-55, 57-59, 61-67, 246-253, 260-263 were rejected under 35 U.S.C. § 112 as omitting essential elements/critical features because they do not recite information stored in a permanent memory in the client computer. Each of the remaining independent claims, claims 10, 38, and 260, have been amended to recite "personal information of the user previously stored in the permanent memory in the client." It is submitted that the rejection have been overcome and it is respectfully requested that the rejection be withdrawn.

Claims 10, 12, 15-16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, and 262-263 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. (U.S. 5,621,456) in view of Schlafly (U.S. 4,734,858).

§103 Rejection of the Claims

Claims 10, 12, 15-16, 21-25, 28, 33-36, 38, 40, 43, 50-54, 58, 60, 63-66, 260, and 262-263 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. (U.S. 5,621,456) in view of Schlafly (U.S. 4,734,858).

The Office action correctly states that Florin fails to disclose or suggest enabling the user to place an order for the item by a single action. The Office action cites Schlafly to show this feature.

Schlafly discloses a pocket size data terminal that is used by the consumer to initially select and store data representative of the orders. (Schlafly, Abstract.) When later connected to a phone line the terminal can be commanded to automatically dial and transmit the stored data in a short burst over a telephone link to a local processing center for processing including customer verification, data format and credit verification, order placement and supplier contact. Each terminal is assigned an internal identification number and a specific local processing center which the terminal can automatically access. (Schlafly, 1: 44-57.) As explained above, the consumer must to initially select and store data representative of the orders. Specifically, Schlafly discloses an ORDER key to store the order data collected from the customer in the send memory. (Schlafly, 9: 12-21.) In order to actually send the order, Schlafly utilizes a send instruction implemented by the ENTER key. (Schlafly, 10: 3-10.) While Schlafly discloses sending the order data to an appropriate destination by actuating the ENTER key, it takes more than a single action on the part of a user to select an item, enter the order-related information, such as the quantity and the supplier (Schlafly, 7: 26-34), save the order data and, finally, transmit the order.

In contrast, claim 10, as amended, recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest responding to a single action by a user by performing



operations that together make it possible to place an order (specifically, a combination of "retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," as recited in claim 10 as amended), claim 10 and its dependent claims are patentable in view of the Schlafly and Florin combination and should be allowed.

Claim 38, as amended, recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, as discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features, claim 38 and its dependent claims are patentable in view of the Schlafly and Florin combination and should be allowed at least for the reasons articulated with respect to claim 10.

Claim 260, as amended, recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client." Because, as discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features, claim 260 is patentable in view of the Schlafly and Florin combination and should be allowed at least for the reasons articulated with respect to claim 10.

Claims 11, 29, 39 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10, 28, 38 and 58 above, and further in view

of Zachary et al. ("Technology: HP is building Gadget to Make TVS Interactive"). Claims 11 and

Claim 11 recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of its being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Zachary is directed at shopping on the interactive TV system (Zachary, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 11 is patentable in view of the Schlafly, Florin, and Zachary combination and should be allowed.

Claim 39 recites "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of its being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Zachary also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 39 is patentable in view of the Schlafly, Florin, and Zachary combination and should be allowed.

Claims 29 and 59 were cancelled.

Claims 13-14, 17, 31-32, 41-42, 45 and 61-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly in view of Pires (U.S. 4,163,255).

Claims 3-14, and 17 recite "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Pires is directed at a billing method for a subscriber of a pay television system (Pires, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 3-14, and 17 are patentable in view of the Schlafly, Florin, and Pires combination and should be allowed.

Claims 41-42, and 45 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Pires also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 41-42, and 45 are patentable in view of the Schlafly, Florin, and Pires combination and should be allowed.

Claims 31-32 and 61-62 were cancelled.

Claims 27, 37, 54-55, 57, 67 and 246-253 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly in view of Harvey et al. (U.S. 4,965,825).

Claim 27 recites "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding

to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Harvey discloses unified system of programming communication for use on individual computer systems with capacity for generating relevant user specific information simultaneously at each station of a plurality of subscriber stations (Harvey, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claim 27 is patentable in view of the Schlafly, Florin, and Harvey combination and should be allowed.

Claims 54-55 and 57 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Harvey discloses unified system of programming communication for use on individual computer systems with capacity for generating relevant user specific information simultaneously at each station of a plurality of subscriber stations (Harvey, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 54-55 and 57 are patentable in view of the Schlafly, Florin, and Harvey combination and should be allowed.

Claims 37, 67, and 246-253 were cancelled.

Claim 261 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claim 260 above, and further in view of Harvey et al. Claim 261 was cancelled.

Claims 18-20 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin et al. and Schlafly as applied to claims 10 and 38 above, and further in view of Mustafa et al. (U.S. 4,789,895).

Claims 18-20 recite "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 10. As discussed above with reference to claim 10, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. Mustafa is directed at a telecommunication system for synchronizing a digital bit stream sent from a central facility to a terminal on lines of television frames (Mustafa, Abstract) and also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 18-20 are patentable in view of the Schlafly, Florin, and Mustafa combination and should be allowed.

Claims 46-48 recite "an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "an event processing module to respond to the single action by ... retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," by virtue of their being dependent on claim 38. As discussed above with reference to claim 38, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest these features. As stated above, Mustafa also fails to disclose or suggest these features, whether considered separately or in combination with Florin and Schlafly. Thus, claims 46-48 are patentable in view of the Schlafly, Florin, and Mustafa combination and should be allowed.

### **RESERVATION OF RIGHTS**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KURIACOSE JOSEPH ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
408-278-4052

Date August 3, 2007

By /Elena Dreszer/

Elena B. Dreszer  
Reg. No. 55,128

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3 day of August 2007.

Peter R. Kuriacose  
Name

[Signature]  
Signature



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/672,523

09/27/2000

Kuriacosc Joseph

2050.001US3

2175

44367

7590

08/15/2007

SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV

P.O. BOX 2938

MINNEAPOLIS, MN 55402-0938

EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

08/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



# **Notice of Non-Compliant Amendment (37 CFR 1.121)**

Application No.

09/672,523

Applicant(s)

Examiner

Garb, V. Gresh

Art Unit

3620

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

The amendment document filed on 8/6/17 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
  - ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
  - ☒ A. A complete listing of all of the claims is not present.
  - ☒ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other: \_\_\_\_\_.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4): \_\_\_\_\_.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

## **TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment, an amendment filed after allowance, or a drawing submission (only). If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

Failure to timely respond to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al.

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Docket No.: 2050.001US3

Serial No.: 09/672,523

Filed: September 27, 2000

Due Date: N/A

Examiner: Yogesh C. Garg

Group Art Unit: 3625

**MS Amendment**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ All Encompassing Statement of Claims (9 pgs.).
- ☒ Consent of Assignee to the Reissue Under 37 C.F.R. 1.172, Power of Attorney, and Proof of Ownership (2 pgs.).
- ☒ Substitute Reissue Declaration (16 pgs.).

If not provided for in a separate paper filed herewith, Please consider this a PETITION FOR EXTENSION OF TIME for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
Customer Number 21186

By: /Elena Dreszer/

Atty: Elena B. Dreszer

Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of May, 2008.

John D. Garg - W. Garg  
Name

John D. Garg - W. Garg  
Signature

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

(GENERAL)

S/N 09/672,523

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kuriacose Joseph et al.

Examiner: Yogesh Garg

Serial No.: 09/672,523

Group Art Unit: 3625

Filed: September 27, 2000

Docket: 2050.001US3

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

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ALL ENCOMPASSING STATEMENT OF CLAIMS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Please find below an all-encompassing statement of claims.

CLAIMS

1 - 9 (Cancelled)

10. (Thrice Amended) A method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including:  
receiving, via a data stream from the server, item data, the item data including  
information to at least one of show and describe the item via the client and an item identifier to  
identify the item as currently being offered for sale;  
presenting at least a portion of the item data to a user;  
receiving a control event associated with a single action effectuated by the user in  
response to the presenting of the at least a portion of the item data;  
responding to the single action by:  
retrieving personal information of the user from a permanent memory in the  
client, and  
combining the item data previously received via the data stream from the server  
with the personal information of the user previously stored in the permanent memory in the client  
to generate an order for the item, and  
transmitting the order for the item from the client.

11. (Pending) The method of claim 10, wherein the single action is one of a group including:  
selecting of a single button; and  
pressing of a single button on a TV remote control.

12. (Cancelled)

13. (Pending) The method of claim 10, wherein the user related, personal information  
includes at least one of a group including a user's name, address, method of payment and  
payment account number.

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

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14. (Pending) The method of claim 10, wherein the user related, personal information is stored in memory in the client.
15. (Pending) The method of claim 10, wherein the distributed computing system is an interactive television system and wherein the at least one of showing and describing of the item is, at least in part, by a television signal.
16. (Pending) The method of claim 10, wherein the client includes an auxiliary data processor and a client computer.
17. (Pending) The method of claim 10, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.
18. (Pending) The method of claim 17, wherein the set top box is in communication with a local computer and associated storage and wherein the method further includes:  
the client retrieving information from one or more of the local computer and the associated storage.
19. (Pending) The method of claim 18, wherein the method further includes: controlling the client by means of the local computer.
20. (Pending) The method of claim 18, wherein the local computer is part of a local area network.
21. (Amended) The method of claim 10, wherein the distributed computer system further includes a central processing facility in communication with the server and wherein the method includes:  
sending information used in processing the order from the client to the central processing facility.

22. (Amended) The method of claim 10, further including:  
receiving an order confirmation at the client.
23. (Pending) The method of claim 21, further including:  
communicating information between the client and the server via the central processing facility.
24. (Pending) The method of claim 23, wherein a telephone system acts as the central processing facility.
- 25-26. (Cancelled)
27. (Twice Amended) The method of claim 10 wherein the item data includes at least one of a group of identifiers including a code and a command.
- 28-32. (Cancelled)
33. (Amended) The method of claim 10, wherein the receiving of the item data via the data stream from the server, comprises receiving the item data via a television signal.
- 34-37. (Cancelled)
38. (Thrice Amended) A computer system to order an item, the system including:  
a data receiver to receive, via a data stream from a server, item data, the item data including information to at least one of show and describe the item, and an item identifier to identify the item as currently being offered for sale;  
a data processing system to present at least a portion of the item data to a user;  
an event detector to detect a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data; and

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an event processing module to respond to the single action by:  
retrieving personal information of the user from a permanent memory in the  
client, and  
combining the item data previously received via the data stream from the server  
with the personal information of the user previously stored in the permanent memory in the client  
to generate an order for the item, and  
transmitting the order for the item from the client.

39. (Pending) The system of claim 38, wherein the single action includes at least one of a group including:

selecting of a single button; and

pressing of a single button on a TV remote control.

40. (Canceled)

41. (Pending) The system of claim 38, wherein the user related, personal information includes at least one of a group including a user's name, address, method of payment and payment account number.

42. (Pending) The system of claim 38, wherein the user related, personal information is stored in memory of the client.

43. (Pending) The system of claim 38, wherein the computer system is an interactive television system and wherein the at least one of showing and describing of the item by the data processing system is, at least in part, performed utilizing a television signal.

44. (Canceled)

45. (Pending) The system of claim 38, wherein the client is associated with at least a set top box, and wherein the user related, personal information is stored at the set top box.

46. (Pending) The system of claim 45, wherein the set top box is in communication with a local computer and associated storage and wherein the client is to retrieve information from one or more of the local computer and the associated storage.
47. (Pending) The system of claim 46, wherein the local computer controls the client.
48. (Pending) The system of claim 46, wherein the local computer is part of a local area network.
49. (Pending) The system of claim 38, including a central processing facility in communication with a server and wherein the client sends information used in processing to the central processing facility.
50. (Pending) The system of claim 49 wherein the server is to send an order confirmation to the user to confirm the order.
51. (Pending) The system of claim 49, wherein the central processing facility is to communicate information between the client and the server.
52. (Pending) The system of claim 51 wherein a telephone system acts as the central processing facility.
53. (Pending) The system of claim 38 wherein the data receiver is to receive the data including:  
information to enable the user to order the item by the single action with respect to the client.
54. (Pending) The system of claim 53 wherein the data receiver includes an auxiliary data extractor to extract the information to at least one of show and describe from the data and a



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packet data extractor to extract the information to enable from the data.

55. (Pending) The system of claim 54 wherein the auxiliary data extractor provides the information to at least one of show and describe to the data processing system and the packet data extractor provides the information to enable to the client.

56. (Canceled)

57. (Pending) The system of claim 38 wherein the item identifier includes at least one a group of identifiers including a code and a command.

58-62. (Cancelled)

63. (Amended) The system of claim 38, wherein the data stream is in the form of a television signal.

64-259. (Cancelled)

260. (Thrice Amended) A machine-readable medium embodying a sequence of instructions that, when executed by a machine, cause the machine to facilitate ordering an item within a distributed computing system including at least one client and at least one server by:

receiving, from a server, item data, the item data including information to at least one of show and describe the item via the client and an item identifier to enable the client to identify the item as currently being offered for sale;

presenting at least a portion of the item data;

receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data; and

responding to the single action by:

retrieving personal information of the user from a permanent memory in the client, and

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combining the item data previously received from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and  
transmitting the order for the item from the client.

261. (Cancelled)

262. (Pending) The machine-readable medium of claim 260, wherein the medium includes a mass storage device.

263 - 357 (Cancelled)

ALL ENCOMPASSING STATEMENT OF CLAIMS

Serial Number: 09/672,523

Filing Date: September 27, 2000

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Page 9

Dkt: 2050.001US3

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
612-373-6900

Date May 29, 2008

By /Elena Dreszer/

Elena B. Dreszer  
Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29 day of May 2008.

Name

John D. Gustin-Woodall

Signature

John D. Gustin-Woodall

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Kuriacose Joseph et al.	Examiner:	Yogesh Garg
Serial No.:	09/672,523	Group Art Unit:	3625
Filed:	September 27, 2000	Docket:	2050.001US3
Patent No.	5,819,034	Issued:	October 6, 1998
Title:	METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM		

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**CONSENT OF ASSIGNEE TO THE REISSUE UNDER 37 C.F.R. §1.172, POWER OF ATTORNEY, AND PROOF OF OWNERSHIP**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

OpenTV, Inc., assignee of the entire right, title and interest in and to U.S. Patent No. 5,819,034, which issued on October 6, 1998 and is entitled "APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM, AND METHOD AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM" hereby consents to the filing of the above-identified reissue application.

I hereby appoint the following attorney(s) and/or patent agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith:

**Customer No. 44367**

I hereby authorize them to act and rely on instructions from and communicate directly with the person/assignee/attorney/firm/organization/who/which first sends/sent this case to them and by whom/which I hereby declare that I have consented after full disclosure to be represented unless/until I instruct Schwegman, Lundberg & Woessner, P.A. to the contrary.

Serial Number: 09/672,523

Dkt: 2050.001US3

Filing Date: September 27, 2000

Title: METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM

Please direct all correspondence in this case to **Schwegman, Lundberg & Woessner, P.A.** at the address indicated below:

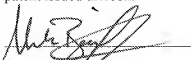
**P.O. Box 2938, Minneapolis, MN 55402**  
**Telephone No. (612)373-6900**

**ASSIGNEE'S PROOF OF OWNERSHIP UNDER 37 CFR § 3.73(b)**

OpenTV, states that it is the owner of record of U.S. Patent No. 5,819,034. Its ownership is established by the assignment recorded at Reel 010263, Frame 0580, of all inventions, technology and improvements described in U.S. Patent No. 5,819,034.

Pursuant to 37 CFR § 3.73(b) I declare that I, Mark Beariault, am empowered to sign this certificate on behalf of the assignee, OpenTV, Inc.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
 OpenTV, Inc.  
 By: Mark Beariault  
 Title: General Counsel

FEBRUARY 21, 2000  
 Date

SCHWEGMAN ■ LUNDBERG ■ WOESSNER

## United States Patent Application

SUBSTITUTE REISSUE DECLARATION

As a below named inventor I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I verily believe I am the original, first and joint inventor of the subject matter which is described and claimed in U.S. Patent No. 5,819,034 which was issued on October 6, 1998, and of the subject matter claimed in the broadening reissue patent application filed on even date herewith which reissue patent application corresponds to U.S. Patent No. 5,819,034, the specification of which is attached hereto.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by the amendment filed herewith.

I verily believe the original patent to be wholly or partly inoperative by reason that the original patent claims less than I had the right to claim in the patent. The claims fail to cover embodiments of the invention and inventions as claimed in the above-identified reissue application. Specifically, the original patent claims fail to include claim 10, reciting "a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method including receiving, via a data stream from the server, item data, the item data including information to at least one of show and describe the item via the client and an item identifier to identify the item as currently being offered for sale; presenting at least a portion of the item data to a user; receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data; responding to the single action by: retrieving personal information of the user from a permanent memory in the client, and combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client."

The error arose without any deceptive intention on my part. The error arose during the drafting of the application and during subsequent amendments in connection with the prosecution of the application which resulted in the issuance of the original patent. The error occurred as a result of the attorney prosecuting the application and I failing to appreciate the scope of the invention and/or to properly identify the invention(s). The error was discovered subsequent to issuance of the original patent during a review of the original patent by the assignee and/or its representatives. I further acknowledge my duty to disclose information which is material to the examination of the application under 37 CFR §1.56.

Attorney Docket No.: 2050.001US3  
Serial No. 09/672,523  
Filing Date: September 27, 2000

Page 2 of 4

I hereby appoint the attorneys associated with the customer number listed below to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith:

**Customer Number: 44367**

I hereby authorize them to act and rely on instructions from and communicate directly with the person/assignee/attorney/firm/organization/who/which first sends/sent this case to them and by whom/which I hereby declare that I have consented after full disclosure to be represented unless/until I instruct Schwegman, Lundberg & Woessner, P.A. to the contrary.

Please direct all correspondence in this case to **Schwegman, Lundberg & Woessner, P.A.** at the address indicated below:

Customer Number: 44367

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of joint inventor number 1: **Kuriacose Joseph**  
Citizenship: **UNITED STATES OF AMERICA** Residence: **Gaithersburg, MD**  
Post Office Address: **16124 Orchard Grove Road**  
**Gaithersburg, MD 20878**

Signature: Kuriacose Joseph  
Kuriacose Joseph

Date: 5/22/2008

Full Name of joint inventor number 2: **Vincent Dureau**  
Citizenship: **France** Residence: **Palo Alto, CA**  
Post Office Address: **3519 S. Court**  
**Palo Alto, CA 94306**

Signature: Vincent Dureau  
Vincent Dureau

Date: \_\_\_\_\_

Full Name of joint inventor number 3: **Alain Delpuch**  
Citizenship: **France** Residence: **Les Essarts Leroi France**  
Post Office Address: **34 Parc Des Essarts**  
**Les Essarts Leroi 78690**  
**France**

Signature: Alain Delpuch  
Alain Delpuch

Date: \_\_\_\_\_

☒ Additional inventors are being named on separately numbered sheets, attached hereto.

Full Name of joint inventor number 4 : Ansley Wayne Jessup

Citizenship: United States of America

Residence: Willingboro, NJ

Post Office Address: 22 Elmwood Lane  
Willingboro, NJ 08046

Signature: \_\_\_\_\_ Date: \_\_\_\_\_  
                    Ansley Wayne Jessup

---

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration (s) submitted in this application, arose without any deceptive intention on the part of the applicant.



§ 1.56 Duty to disclose information material to patentability.

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SCHWEGMAN ■ LUNDBERG ■ WOESSNER

**United States Patent Application**  
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Residence: Gaithersburg, MD

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Signature: \_\_\_\_\_ Date: 09/27/00  
Vincent Dureau

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Citizenship: France  
Post Office Address: 34 Pare Des Essarts  
Les Essarts Leroi 78690  
France  
Residence: Les Essarts Leroi France

Signature: \_\_\_\_\_ Date: \_\_\_\_\_  
Alain Delpuch

☒ Additional inventors are being named on separately numbered sheets, attached hereto.

Full Name of joint inventor number 4 : Ansley Wayne Jessup  
Citizenship: United States of America Residence: Willingboro, NJ  
Post Office Address: 22 Elmwood Lane  
Willingboro, NJ 08046

Signature: \_\_\_\_\_ Date: \_\_\_\_\_  
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SCHWEGMAN ■ LUNDBERG ■ WOESSNER

## United States Patent Application

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Post Office Address: ~~34 Parc Des Decartes~~ 310 rue Le Brun  
~~Les Essarts Le Roi 78690~~ 75013 PARIS  
France

Residence: PARIS, FRANCE <sup>AD</sup> 5/27/08  
~~Les Essarts Le Roi France~~

Signature:  \_\_\_\_\_ Date: May 27, 2008  
Alain Delpuch

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Citizenship: **United States of America**

Residence: **Willingboro, NJ**

Post Office Address: 22 Elmwood Lane  
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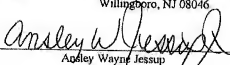
Full Name of joint inventor number 4: Ansley Wayne Jessup

Citizenship: United States of America

Residence: Willingboro, NJ

Post Office Address: 22 Elmwood Lane  
Willingboro, NJ 08046

Signature: \_\_\_\_\_

  
Ansley Wayne Jessup

Date: \_\_\_\_\_

March 1, 2008

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**REQUEST  
FOR  
CONTINUED EXAMINATION (RCE)  
TRANSMITTAL**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,  
provides for continued examination of an utility or plant application  
filed on or after June 8, 1995.  
See The American Inventors Protection Act of 1999 (AIPA).

<i>Application Number</i>	09/672,523
<i>Filing Date</i>	September 27, 2000
<i>First Named Inventor</i>	Kuriacose Joseph
<i>Confirmation Number</i>	2175
<i>Group Art Unit</i>	3625
<i>Examiner Name</i>	Yogesh Garg
<i>Attorney Docket Number</i>	2050.001US3
<i>Customer No.</i>	44367

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application  
entitled

**METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM**

1. Submission required under 37 C.F.R. § 1.114:

- ☒ Amendment Under 37 C.F.R. § 1.116 (5 pages) is enclosed.
- ☒ Information Disclosure Statement (2 pages), Form 1449 (2 pages), and copies of cited documents (20).
- ☒ Substitute Reissue Declaration (16 pgs)

2. Fees

- ☒ Authorization to charge deposit account 19-0743 in the amount of \$810.00 to pay the RCE filing fee required  
under 37 C.F.R. § 1.17(e).
- ☒ The Commissioner is hereby authorized to charge any additional fees or credit overpayment to Deposit  
Account No. 19-0743.

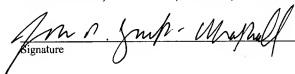
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

By: /Elena Dreszer/

Elena B. Dreszer  
Reg. No. 55,128

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic  
filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this  
30 day of March, 2009.

John D. Gustav-Wrathall  
Name Paralegal  
**Schwegman, Lundberg & Woessner**

  
Signature

**EXPEDITED PROCEDURE-EXAMINING GROUP 3625**

**S/N 09/672,523**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Kuriacose Joseph et al.	Examiner:	Yogesh Garg
Serial No.:	09/672,523	Group Art Unit:	3625
Filed:	September 27, 2000	Docket No.:	2050.001US3
Customer No.:	44367	Confirmation No.:	2175
Title:	METHOD AND SYSTEM TO FACILITATE ORDERING OF AN ITEM		

---

**AMENDMENT & RESPONSE UNDER 37 C.F.R. 1.116**

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Final Office Action dated January 6, 2009, please amend the application as follows:

### **REMARKS**

This responds to the Final Office Action dated January 6, 2009.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260-262 remain pending in this application.

#### **Substitute Oath/Declaration**

The substitute declaration filed on May 29, 2008 was found defective. Corrected substitute declaration is being filed herewith.

#### **§ 251 Rejection of the Claims**

Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."<sup>1</sup>

A brief reference to the prosecution history may be useful here. The issue of recapture under 35 U.S.C. § 251 has already been raised before, in the Final Office Action dated May 5, 2006. Following the Applicants' arguments, the rejection of claims under 35 U.S.C. § 251 was withdrawn. Specifically, in the Office Action mailed on May 03, 2007, the Examiner stated the reason for withdrawing the rejection under 35 U.S.C. § 251 being that the subject matter of the claims is new and not related to the claimed subject matter surrendered in the patent application upon which the present reissue is based.

Referring to the discussion provided in the Final Office Action mailed January 6, 2009, the Examiner states that claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9 and concludes that the claims are barred by the recapture rule. The recapture

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<sup>1</sup> Final Office Action mailed January 6, 2009, page 4.



rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP 1412.02 titled "Recapture of Canceled Subject Matter." In the pertinent part, MPEP 1412.02 states that if the reissue claims are claiming additional inventions or embodiments not originally claimed, then recapture is not present, and that the complete removal of a limitation that was added to obtain the patent is permitted where the replacement limitation provides a separate invention.<sup>2</sup>

In the present reissue application, the claims are directed to method and system of facilitating ordering an item, where the order is placed in response to a single action by the user, and thus are related to additional inventions when compared to the inventions claimed in the original patent (e.g., a system configured to receive and execute a distributed computing application that alters an associated video program). Because the reissue claims are claiming additional inventions not originally claimed, the recapture is not present. It is respectfully requested that the rejection be reconsidered and withdrawn.

*The Finality of the Office Action is Improper*

Pursuant to MPEP 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement."<sup>3</sup> Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260 and 262 were rejected under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based."

It will be noted that the Office Action immediately preceding the Final Office Action dated January 6, 2009 did not set forth a rejection under 35 U.S.C. § 251 for the reason of improper recapture. Thus, because the Examiner was silent in the earlier paper with respect to the issue of recapture and, as a result, the Applicants were not afforded an opportunity to

<sup>2</sup> MPEP 1412.02 (I)(C). ("If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.")

<sup>3</sup> Final Office Action mailed January 6, 2009, page 4.

respond, the rejection of the claims as improper recapture is a new ground of rejection<sup>4</sup> that renders the Final Office Action dated January 6, 2009 an improper Final Office Action. It is respectfully requested that the finality of the Final Office Action be withdrawn.

Furthermore, it will be noted that the Applicants submitted the substitute declaration in reliance on the Examiner's input with respect to the proposed substitute declaration. Specifically, the allegedly defective declaration was revised by and informally approved by the Examiner, as is evident from the documents provided in Appendix A (email exchange between the Applicants' representative and the Examiner), Appendix B (Applicants' proposed substitute declaration), and Appendix C (substitute declaration revised by the Examiner). Because the substitute declaration was filed on May 29, 2008 in reliance on the informal approval by the Examiner, the rejection of the substitute declaration as defective is equivalent to a new ground of rejection by the Examiner. Therefore, the Final Office Action dated January 6, 2009 is an improper Final Office Action. It is respectfully requested that the finality of the Final Office Action be withdrawn for this additional reason.

One-Click Patent

The Office should be aware of U.S. patent no. 5,960,411, conventionally known as Amazon One-Click patent, that claims certain aspects of placing an order for an item in response to a single action being performed. It will be noted that the priority date of the U.S. patent no. 5,960,411 is September 12, 1997, which is subsequent to the filing date of the original patent that is April 28, 1994. The U.S. patent no. 5,960,411 is thus not prior art with respect to the present reissue application.

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<sup>4</sup> *Ex parte Mahur*, Appeal No. 95-4103, 1996 WL 1795838 at \*9.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(408) 278-4052

Date March 30, 2009

By /Elena Dreszer/  
Elena B. Dreszer  
Reg. No. 55,128

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 26, 2009.

30 706w  
Name John D. Gustav-Wrathall  
Paralegal  
Schwegman, Lundberg & Woessner

Signature 

SCHWEGMAN ■ LUNDBERG ■ WOESSNER

## United States Patent Application

SUBSTITUTE REISSUE DECLARATION

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My residence, post office address and citizenship are as stated below next to my name;

I verily believe I am the original, first and joint inventor of the subject matter which is described and claimed in U.S. Patent No. 5,819,034 which was issued on October 6, 1998, and of the subject matter claimed in the broadening reissue patent application filed on even date herewith which reissue patent application corresponds to U.S. Patent No. 5,819,034, the specification of which is attached hereto.

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Gaithersburg, MD 20878

Residence: Gaithersburg, MD

Signature: Kuriacose Joseph  
Kuriacose Joseph

Date: February 20, 2009

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Citizenship: France  
Post Office Address: 3519 S. Court  
Palo Alto, CA 94306

Residence: Palo Alto, CA

Signature: \_\_\_\_\_  
Vincent Dureau

Date: \_\_\_\_\_

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Post Office Address: 36 rue Le Brun  
Paris 75013  
France

Residence: Paris, France

Signature: \_\_\_\_\_  
Alain Delpuch

Date: \_\_\_\_\_

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Citizenship: United States of America

Post Office Address: 22 Elmwood Lane  
Willingboro, NJ 08046

Residence: Willingboro, NJ

Signature: \_\_\_\_\_ Date: \_\_\_\_\_  
Ansley Wayne Jessup

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(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

SCHWEGMAN ■ LUNDBERG ■ WOESSNER

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Kuriacose Joseph

Full Name of joint inventor number 2 : Vincent Dureau  
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Date: \_\_\_\_\_

Mar. 13 2019

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration (s) submitted in this application, arose without any deceptive intention on the part of the applicant.

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.